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CHARLES ELMORE CROPLI
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IN THE
Supreme Court of the United States

OCTOBER TERM, 1937.

No. 608

LINCOLN ENGINEERING CO. OF ILLINOIS,
Petitioner,

vs.

STEWART-WARNER CORPORATION,
Respondent.

**THE OPINION OF THE UNITED STATES CIRCUIT COURT OF AP-
PEALS FOR THE SEVENTH CIRCUIT, AND THE OPINIONS AND
FINDINGS OF THE DISTRICT COURT, APPROVED AND ADOPTED
BY THE COURT OF APPEALS.**

**Supplement to the Respondent's Brief in Opposition to Petition for
Writ of Certiorari.**

LYNN A. WILLIAMS,
Counsel for Respondent.

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SECTION I

Opinion of Judge Lindley Upon Merits of Case Delivered
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STEWART-WARNER CORPORATION v. LE
VALLY et al.
No. 13955.

District Court, N. D. Illinois, E. D.
July 15, 1936.

1. Patents \S 26(1)

"Combination patent" may consist either of one or more old elements, plus one or more new elements; or of a plurality of elements, all of which are old; or of a plurality of elements, all of which are new.

[Ed. Note.—For other definitions of "Combination Patent," see Words & Phrases.]

1. Patents \S 26(1½)

Old elements in new valid combination constitute "invention" and are as much a unit in contemplation of law as a single or noncomposite instrument.

[Ed. Note.—For other definitions of "Invent; Invention," see Words & Phrases.]

1. Patent \S 26(1¾)

No one element of combination patent is gist of combination, but it is the co-operative, co-ordinating, unified result, wherein the various elements contribute to one unitary result, which constitutes "invention."

1. Patents \S 26(2)

New combination of old elements, each of which contributes to new and unitary result, is patentable.

5. Patents \S 260

Defendant in suit for contributory infringement of patent which did not begin manufacture of infringing device until after commercial success was achieved by assignee of patent was estopped from asserting that patentee's nonuse rendered patent subject to strict construction.

1. Patents \S 323

Butler patent, No. 1,593,791, claim 2, describing combination for lubricating automobiles, held valid and contributorily infringed by manufacturer of fittings which

were sold with knowledge and understanding that they were to be used in co-operation with one element of patented combination.

In Equity. Suit by the Stewart-Warner Corporation against John R. Le Vally and another, doing business as the Lincoln Engineering Company of Illinois, and another for contributory infringement of one claim of a patent.

Decree in accordance with opinion.

Williams, Bradbury, McCaleb & Hinkle, of Chicago, Ill., for plaintiff.

Wilkinson, Huxley, Byron & Knight, of Chicago, Ill., and Delos G. Haynes and Lloyd R. Koenig, both of St. Louis, Mo., for defendants.

LINDLEY, District Judge.

Plaintiff, as assignee and owner of patent No. 1,593,791 to Butler, applied for February 19, 1923, and allowed July 27, 1926, sues the Lincoln Engineering Company of Illinois for contributory infringement of claim 2. The defenses are invalidity and noninfringement.

Claim 2 of the Butler patent describes a lubricating system for automobiles or other machines, essentially high pressure in character, in which each bearing is provided with a headed nipple for receiving oil or grease of a lubricant compressor having a coupling member for connecting said compressor with the nipples. The coupler is slipped easily and somewhat loosely over the nipple head. As the operator pushes on the compressor, the pressure of the lubricant moves a piston within the cylinder in such a manner as to cause the locking or gripping jaws to clutch or grab about or upon the nipple head. At the same time the grease under pressure acts also upon an apertured sealing seat, carried by the jaws and actuated by the piston in such a way as to engage the end of the nipple and thereby produce a tight seal. Gripping, grabbing, or clutching of

Claim 2. The combination with a headed nipple for receiving lubricant, of a lubricant compressor having a coupling member for connecting said compressor and nipple comprising a cylinder, a piston movable within the cylinder, and having an aperture for the discharge of lubricant thereof, an apertured sealing seat carried by said piston for engagement with the end of the nipple, connecting the pis-

ton aperture with a passage through the nipple radially movable locking elements carried by the cylinder coacting with the nipple and actuated by said piston for compressively clutching the elements upon the nipple whereby the pressure of the lubricant on said piston will move the piston to forcibly compress said elements while the lubricant is passing through said connecting parts.

the nipple is effected automatically, and engagement of the seal against the end of the nipple is achieved in the same manner. Both of these functions are effectuated by the pressure of the lubricant, without other manipulation of the coupler. Thus, the coupler and nipple are so constructed as to produce an essential relationship between the two functions and the mechanism for performing them. Yet each of the two functions is carried out completely and perfectly without interference by the other. As a result, the operation is successful even though there be considerable variation in the precise dimensions in the forms and parts involved.

Upon analysis we find that the claim includes seven elements; namely, a headed nipple, a compressor or pump, a cylinder, a piston, an opening in the piston, a sealing seat, and laterally or radially moving locking elements or jaws. Admittedly, each of these elements is old, and plaintiff makes no claim of invention because of the presence of any one of the particular elements, but insists that invention resides in a new combination of old elements so associated, related and interrelated as to accomplish a new result.

The headed nipples are adapted to be screwed to each of the bearings of an automobile; the compressors are intended to be filled with grease and then to be coupled in succession to each of the nipples in order to inject grease into the openings of the several bearings. Consequently, the combination of the nipple, compressor, and coupler is brought together only periodically and temporarily and in the hands of the owners or servicers of the car. The manufacturer of the car buys the headed nipples and inserts them in the bearings. An automobile may require 25 to 60 such fittings. Some bearings can be conveniently greased with a straight nipple; others with an elbow nipple, at angles varying from 90° to 22½°. Some of the nipples are long, others short, and they are screwed into holes tapped with different pipe thread sizes. Consequently, the manufacturer of the device separately lists and prices each of the sizes of compressor which may be coupled to and used in conjunction with the nipples. Thus the purchaser may buy such nipples as he desires and a compressor of small capacity or one of large capacity, or even a power-driven compressor. An automobile owner may never use a compressor. He may have his car greased at a garage,

and in such case the combination occurs only when the car is greased.

In this respect the combination differs from that usually found in industry. Ordinarily, a manufacturer makes and sells a complete combination, but in the business of high-pressure lubricating equipment, parts are necessarily sold separately. Prior to the commencement of this suit some 6,000,000 Alemite hydraulic guns and compressors claimed to have been embodied within the Butler patent were sold by plaintiff, and during the same period distributed some 218,000,000 of its so-called Alemite hydraulic system nipples.

For seven years prior to January, 1933, the Lincoln Engineering Company of St. Louis, Mo., who is defending this suit, and who is treated herein as the real defendant, had manufactured grease guns for plaintiff. The latter took all of its product. Stewart-Warner had furnished couplers and nozzles to Lincoln, and the latter had incorporated them in compressors, which it in turn sold to Stewart-Warner. These compressors and nozzles were used in combination with hundreds of millions of Gullborg pin fittings and Zerk push type fittings manufactured and sold by plaintiff.

Early in 1933, the Lincoln Company decided to undertake the direct sale of its compressors to service stations and garages and took steps to create a distributing organization for such purpose. Prior to that time, for many years, practically all American-made automobiles had been equipped at their factories with pin fittings sold and manufactured by plaintiff under Gullborg or with push type fittings, manufactured and sold by plaintiff under Zerk. Hundreds of millions of these nipples were in the field, practically to the exclusion of anything else adapted to lubrication of automobile bearings. Consequently, the Lincoln Company, in order to sell its compressors, found it necessary to incorporate a terminal of such character as would connect with and co-operate satisfactorily with these Gullborg and Zerk nipples. As a result it brought out its N-1 needle type nozzles.

In April, 1933, plaintiff through its subsidiary the Alemite Corporation, put on the market its new Alemite hydraulic system involving the combination now relied upon. Soon thereafter the Lincoln Company, in its advertising, claimed that its compressors could be used not only with Gullborg fittings and Zerk push type

nozzles but also with the headed nipple of the Alemite Corporation which plaintiff claims is protected by the Butler combination patent.

In July, 1934, Lincoln's advertising literature illustrated all three types of fittings as the various kinds of nipples with which the Lincoln compressor and nozzle were intended to be combined and used. Thus far, however, the Lincoln Company had not manufactured or sold any nipples of any kind for use in the lubrication of automobiles. But in the summer or early fall of 1934, after the Alemite system had been on the market for one and a half years, Lincoln entered upon negotiations with General Motors Corporation to sell to it in lieu of Alemite hydraulic fittings, theretofore manufactured and sold to it by plaintiff, a new fitting to be manufactured for the first time by Lincoln. The negotiators had under discussion round-headed and straight-sided nipples, without head, shoulder, or peripheral groove, not adapted for co-operation with the gripping jaws of the Alemite hydraulic coupler, but properly adapted for use in conjunction with the Lincoln N-1 nozzle and Lincoln Snap-On coupler.

No straight-sided nipples, other than a few samples, were manufactured or sold. On the other hand, Lincoln began to manufacture a peripherally grooved, shouldered, and headed nipple of form, size, and dimensions as to afford perfect co-operation with the gripping jaws of the Alemite hydraulic coupler. The first of these nipples were shipped to the Oldsmobile factory on November 24, 1934, and displaced the purchase and use of the Alemite fitting. Shortly thereafter, Cadillac, Buick, and Pontiac switched from the peripherally grooved and headed nipples of plaintiff to those of Lincoln. These branches of General Motors, however, except as to cars sold in foreign countries, included no purchase of couplers.

For eighteen months plaintiff had attempted to put its new coupler into the hands of every garage and service station in the United States. On April 1, 1935, 2,385,148 such couplers had been sold. It appears clearly that the sale of Lincoln Kleen Seal fittings dates from the shipment made to Oldsmobile and that the fittings satisfactorily serves with plaintiff's compressor. Thus, the purchasers of automobiles from General Motors divisions could have their cars, equipped with Kleen Seal

fittings, greased with the Alemite hydraulic compressors and couplers then in the hands of the service stations and garages through the country.

Mr. Fox, an engineer for Lincoln, became familiar with plaintiff's headed nipple shortly after its first appearance on the market in April, 1933. The automobile trade papers were, in that spring, summer, and fall, replete with advertisements and reading notices illustrating and describing every detail of plaintiff's hydraulic coupler, and Lincoln in July, 1934, illustrated in its circulars, Alemite headed nipples as being capable of combination with the Lincoln compressor. It is only a fair inference that during all of this period Lincoln, which seems to have been alert in its business, knew about and understood the Alemite compressor. At any rate, Mr. Fox admits that he became familiar with the coupler in January, 1935, and from that time on, Lincoln sold its peripherally grooved, shouldered, and headed nipples, adapted for satisfactory co-operation with the Alemite hydraulic compressor, with the knowledge that the purchasers of the Lincoln nipples could use them and would use them in conjunction and combination with the Alemite compressors and couplers. Furthermore, that company became familiar with the Alemite fittings immediately upon their appearance in April, 1933, and when the Lincoln nipples were first put on the market in November, 1934, they were in some thirty odd styles having arbitrary dimensions corresponding with those of the Alemite headed nipples and having their structure of such size, form, and dimensions as to make them completely interchangeable with Alemite nipples.

On April 17, 1935, a representative of plaintiff went to the place of business of Lincoln in Chicago and said to the man behind the counter that he wanted to purchase some nipples to be used with a gun which he then produced, an Alemite hydraulic compressor and coupler. The man produced Lincoln fittings. The witness tried them in co-operation with the gun and found that they co-operated with the Alemite compressor and coupler; purchased the fittings and took them away with him. He subsequently made other purchases of similar fittings for the same purpose. It thus appears in evidence that Lincoln sold the fittings upon the express understanding that they were to be used in combination with plaintiff's compressor

then exhibited to the salesman. At all times thereafter, Lincoln sold its peripherally grooved, headed, and shouldered fittings in commercial displacement of plaintiff's fittings with the knowledge and understanding that the Lincoln nipples thus sold could be used and would be used by the purchaser in conjunction with plaintiff's compressor and coupler part of the complete combination under the Butler patent.

This brings us, then, to the issue in this case; that of contributory infringement. If the combination of the Lincoln nipples with the plaintiff's hydraulic compressor and coupler embodies claim 2 of the Butler patent in suit and that claim is valid, then we have a clear case of contributory infringement.

The testimony shows a complete response of the combination of the Lincoln fittings and plaintiff's Alemite hydraulic compressor and coupler to claim 2 of the Butler patent. Every element included in claim 2 is included in such combination, and the demonstrations disclose that the co-operation and the functions thereof in this combination are the same as the combination of the plaintiff's compressor coupler, and fittings.

But defendant insists that claim is invalid. It relies largely upon the case of *Stewart-Warner Corporation v. Jiffy Lubricator Co.*, 81 F. (2d) 786, 792 (C.C.A. 8). There the court held claim 1 of the Butler patent, while valid, not infringed by the Jiffy Company's sale of a certain coupler intended for use in conjunction with the cylindrically projecting end of an Alemite pin fitting. Claim 1 is not involved in this case. It included a fitting in the combination, and the claim is similar to claim 2, but the nipple is not headed. In the Jiffy Case, the nipple considered did not have head, throat, or shoulders. It was a perfectly smooth straight cylinder, and the Circuit Court of Appeals was of the opinion that the gripping action of the segmental jaws as disclosed in the Butler patent would not be sufficiently powerful to hold the coupler to such a plain, cylindrical nipple under the force of grease under pressure of several thousand pounds per square inch. The court said:

"But when we turn to the Butler patent specifications disclosing the 'means' he had in mind for 'comprehensively engaging about the nipple for locking said parts together,' we find no reference to any elements cor-

responding to such positive wedging means as above-described. He describes a nipple having a head, a throat, and a shoulder, and segments adapted to slip over the head of such a nipple and embrace the throat thereof. Then he specifies spring fingers mounted on the forward face of the piston. Ample room is left in the cylinder for the free play of the spring fingers. As the piston is moved forward by the pressure of the lubricant, the spring fingers do engage and press upon the segments so that the segments are pressed upon the throat of the nipple. But the nipple is not specified to be held against longitudinal displacement by the force of the gripping. The language of the specifications is that the segments are held in position on the throat by the spring fingers, but it is the 'shoulder' on the nipple which 'prevents the retraction of the segments' or pulling away from the nipple. We conclude from consideration of all the specifications and the drawing that the inventor excluded disclosure of elements which would be actuated by the forward movement of the piston to lock the coupler to the nipple by an unyielding wedging action, but that he disclosed only such a yielding compression as should be accomplished by spring fingers.

"We find the difference between the Butler patent and the Jiffy coupler substantial, in that the mechanical or engineering principle on which the Butler patent compresses the jaws of its chuck about the bearing nipple is different from that relied upon in the Jiffy structure. As they are not mechanical equivalents and as it does not appear that Butler invented or disclosed such a chuck as that made by Jiffy, there was no infringement."

Consequently, the opinion is of no aid in the decision of this case. Here we are dealing with a nipple of the character described by Butler in claim 2, with a head, a throat, and a shoulder. The coupler incorporates segments adapted to slip over the head of such a nipple and embrace and grasp the throat thereof. It is the shoulder on the nipple which prevents the retraction of the segments. The nipple discussed in the Jiffy Case, as the court pointed out, was not of such construction. It would not prevent longitudinal displacement by the force of the gripping of a compressor of Butler's type, although it would co-operate with the Jiffy compressor held not to infringe. It did not have the shoulder which prevents retraction of the

segments or the pulling away from the nipple. Lincoln sells a headed nipple, to be substituted for the plaintiff's headed nipple. It has a head, a throat, and shoulders, and when used in conjunction with the Alemite hydraulic coupler, the segments of the coupler slip over the head of the defendant's nipple and embrace the throat thereof and clutch the head within the meaning of Butler's specifications and claims.

Defendant insists that this case is controlled by the recent decisions of the Supreme Court in *Bassick Manufacturing Company v. R. M. Hollingshead Company* (6 S. Rogers et al. v. Alemite Corporation), 58 S.Ct. 787, 80 L.Ed. —, and it becomes necessary to examine those decisions with some care.

These cases went to the Supreme Court when the Gullborg patent was about to expire. The question of validity of the patents involved had been raised in many District Courts and the patents held valid and infringed in various Circuit Courts of Appeals. Unfortunately, the record was rather short. Plaintiff in the Hollingshead Case offered in evidence a sample of defendant's device and relied upon physical demonstration to show that uncoupling involved the suction effect of Gullborg.

From a decree finding infringement in the sale of the compressor and coupler of the type complained of, the Hollingshead Company appealed and argued that the device complained of had no suction effect. The Circuit Court of Appeals affirmed, 73 F.(2d) 543 (C.C.A.6). The Supreme Court took jurisdiction, and the question presented was as to the validity of the Gullborg patent, and whether the device complained of utilized the suction effect of the Gullborg claims. The Supreme Court held the claims valid; but said that the suction effect construction had not been proved and that the accused device did not involve the novel feature claimed in the patent. Clearly the case was determined upon a question of fact and the decision is of no help here, except in so far as it implies that if the device had been shown to be of the suction effect type, its manufacture and sale would have been held to constitute contributory infringement.

The language of the opinion indicates no intention to upset or to reverse anything that has been previously announced

as to the character of a combination patent. Such an invention is defined by Mr. Justice McKenna in *Leeds & Catlin Co. v. Victor Talking Machine Co.*, 213 U.S. 325, at page 332, 29 S.Ct. 503, 505, 53 L.Ed. 816, as follows: "A combination is a composition of elements, some of which may be old and others new, or all old or all new. It is, however, the combination that is the invention, and is as much a unit in contemplation of law as a single or noncomposite instrument. Whoever uses it without permission is an infringer of it. Whoever contributes to such use is an infringer of it. It may be well here to get rid of a misleading consideration. It can make no difference as to the infringement or noninfringement of a combination that one of its elements or all of its elements are unpatented."

In the companion case of *Leeds & Catlin Co. v. Victor Talking Machine Co.*, 213 U.S. 301, at page 318, 29 S.Ct. 495, 500, 53 L.Ed. 805, he said:

"A combination is a union of elements which may be partly old and partly new, or wholly old or wholly new. But, whether new or old, the combination is a means—an invention—distinct from them. They, if new, may be inventions and the proper subjects of patents, or they may be covered by claims in the same patent with the combination.

"But whether put in the same patent with the combination or made the subjects of separate patents, they are not identical with the combination. To be come that they must be united under the same co-operative law. Certainly, one element is not the combination, nor in any proper sense, can it be regarded as a substantive part of the invention represented by the combination, and it can make no difference whether the element was always free or becomes free by the expiration of a prior patent, foreign or domestic. In making a combination, an inventor has the whole field of mechanics to draw from. This view is in accordance with the principles of patent laws. It is in accordance with the policy of § 4887 of the Revised Statutes, which is urged against it."

I find nothing in the Hollingshead Case that purports in any way to disturb the previous announcements of the Supreme Court. Rather, it seems to me, the court reaffirms its adherence to its former holding.

[1-3] It is well to observe that there are three classes of combination patents as follows:

(1) One or more old elements, plus one or more new elements.

(2) A plurality of elements, all of which are old.

(3) A plurality of elements, all of which are new.

Obviously to any trial judge, in their final analyses, almost all patentable combinations are of the second class; namely, those in which all of the elements are of themselves old. The old elements in a new valid combination, as the Supreme Court says, constitute invention and are as much a unit in contemplation of the law as a single or noncomposite instrument. There is no one element that can be said to be the gist of the combination, but it is the co-operative, co-ordinating, unified result, wherein the various elements contribute to one unitary result, which constitutes invention. It is misleading, therefore, to speak of any one element as the essence of the invention. Thus, in *Automotive Parts Co. v. Wisconsin Axle Co.*, 81 F. (2d) 125, at page 126 (C.C.A.8), the court said: "The invention is for a composite thing, embracing several elements or parts, all of which are necessary to and co-operate in the operation of the patented unit. We cannot subscribe to the view that the test of contributory infringement in the furnishing of parts for a combination invention is whether the parts furnished constitute the gist or essence of the invention; indeed, we cannot see how it may be said that any one element or another marks the advance step or is the essence of such an invention. There are cases, it is true, in which the phrase 'essence of the invention' is used; but in our view, when the facts in those cases are considered, it cannot be said that the conclusions reached were the result of a logical selection of one or more elements of the combination as the gist or essence of the invention."

And the Supreme Court said in *Leeds & Catlin Co. v. Victor Talking Machine Co.*, 213 U.S. 301, 29 S.Ct. 495, 500, 53 L. Ed. 805, "Certainly, one element is not the combination, nor, in any proper sense, can it be regarded as a substantive part of the invention represented by the combination."

The word "substantive" means "an essential part" or "constituent" or "relating to what is essential."

[4] The question, of course, always whether there is a new patentable combination which produces a new and unitary result. The operation and functioning of all of the old elements of the new combination must be affected by their presence in the new combination and each part must contribute its part to the unitary result. Otherwise, we have an unpatentable aggregation. But if the operation or functioning of each of the old elements is in some way affected by its presence in the new combination in such a way as to contribute to the accomplishment of a new unitary result, then we have a valid patent claim.

In the *Rogers Case*, apparently, in District Court the trial revolved about the question of whether the defendant made its products with the knowledge that they would be used in conjunction with parts sold by plaintiff. But in the Supreme Court this question of fact was abandoned and the defendant's contentions were that the Gullborg patent was invalid and that plaintiff was illegally extending its monopoly. The court held that the plaintiff might not extend the monopoly of its patent. But we do not understand that decision in any way sought to review the prior announcement of the Supreme Court upon the subject of contributory infringement. The court did not so expressly hold and I find in the opinion no such implication.

However, the court held that the defence was that the prior art embraced the use in combination of a grease gun composed of a chamber or pump, a hose, a bayonet coupler, and a spring-closed fitting, the coupling being of the pin and slot or bayonet type. This prior art arose from Gullborg's earlier patent, No. 1,307,733, and the *Seng French* patent, No. 468,899. The court observed that the plaintiff's position was that when defendant furnished a part of this old unpatented and unpatentable combination, for use with the fitting of Gullborg, No. 1,307,733, it contributorily infringed claims 14 and 15 of the patent in suit, because those claims describe the combination of any grease gun with the patented pin fittings. For the invention of his fitting, Gullborg had previously applied for and obtained a patent, No. 1,307,733, not then in suit. Claims of the Gullborg patent then in suit described a combination consisting of the fitting of Gullborg's patent, No. 1,307,733, with any grease pump having a bayonet

coupler. The court said that the question then was whether claims 14 and 15, unless restricted to the combination of a grease gun and coupler and a pin fitting such as are described in the specifications of the patent, are void as attempting to extend Gullborg patent, No. 1,307,733, to the use therewith of any grease gun not having the suction device of the patent in suit. It held that though claims 14 and 15 are for a combination using a device of a prior patent, with grease gun or coupler of any type, they must be read as claiming only a combination of pin fittings and a gun, with coupling device having the suction effect set forth in Gullborg's patent; otherwise, the claims would be void as unlawful attempts to extend the monopoly of the pin fitting in patent 1,307,733.

The court observes that Rogers neither made nor sold pin fittings of the type covered by Gullborg, No. 1,307,733, and observed that the question was whether the patentee might further claim the combination between the patented pin fittings and any form of grease gun. He would thereby in effect be repatenting the old combination by reclaiming it with the improved element substituted for the old element. This the court said could not be done.

The thought underlying the court's remarks was that except for the suction-effect coupler combination, Gullborg had made but one invention; namely, his particular form of pin fitting; that his right to patent protection had been exhausted in his patent 1,307,733; and that he could not be permitted to extend the monopoly of this old patent. The court, in effect, reaffirmed *Leeds & Catlin Co. v. Victor Talking Machine Co.*, 213 U.S. 301, 325, 29 S.Ct. 495, 53 L.Ed. 805.

The rather startling feature of the Supreme Court's opinion is the announcement that the Leeds Case patent to Berliner, No. 534,543, was a pioneer patent. I consider this unimportant, because evidently the Supreme Court has extended, intentionally or otherwise, the meaning of the word "pioneer," for in the Leeds Case the two earlier patents, 372,786 and 382,790, described and claimed substantially everything in Berliner, 534,543, then being considered, in the way of disc, record, cabinet, and record in phonograph machines. There was an improvement, however, which I shall later discuss. As a matter of fact, the original phonograph goes back to Edison's patent in 1878. Many other

delivers in the art have procured patents since then, but Bell and Tainter, No. 341,214, includes most of the prior art. As compared with that, the Berliner invention consisted in permitting the stylus of the reproducer to be propelled by and along the sound groove of the record tablet all the way from its outer circumference to its inner end. To accomplish this, it made use of a mounting for the reproducer which would permit it to travel freely throughout this distance. Berliner's invention resided in giving the reproducer a greater degree of freedom of movement to follow the groove in the record, and, by doing so, eliminating the necessity of providing means for relatively shifting the record and reproducer. The new thing was the unrestricted pivotal mounting. This was pointed out by Judge Hasel in the trial court (*Victor Talking Machine Co. v. American Graphophone Co.* [C.C.] 140 F. 860) and by Judge Hough in the Circuit Court of Appeals in *Leeds & Catlin Co. v. Victor Talking Machine Co.*, 154 F. 58, 23 L.R.A. (N.S.) 1027. Consequently, the statement of the Supreme Court in the Leeds Case that the patent was a pioneer must be taken into consideration with the record disclosing its place in the history of the art.

In *Leeds & Catlin Co. v. Victor Talking Machine Co.*, 213 U.S. 301, 311, 29 S.Ct. 495, 53 L.Ed. 805, the court had to do with a combination consisting of the elements: (1) A traveling disc having a sound record formed thereon; (2) a reproducing stylus, shaped for engagement with the record and free to be vibrated and propelled by it. It was, therefore, a true mechanical combination device, producing by the co-operation of its constituents the result specified in the manner specified. The Leeds records were equally suitable for use in connection with the Victor machine as well as their own machines. The court held that there was contributory infringement.

The result was in general the old result of producing or reproducing articulate sounds. But the new and unitary result was the production of articulate sounds by the automatic swing of the stylus across the disc record; in this respect only the patent was a pioneer. Everything else was old. The new thing was the pivot or hinge for the stylus so that it might be propelled by the record all the way across the face of the record. The various elements pre-

sessed no utility without co-operation in combination. Each element was necessary to the operation of the whole.

From an examination of the Leeds opinion I believed that the basis of the decision relative to the Gullborg patent was that this inventor of pin fitting, part of the complete combination, part of which had already been separately patented, did not bring about any new mode of operation or co-operation in or among the other elements thereof. It did not alter or modify or give new functions to any of the other parts of the combination; and, therefore, the old parts did not participate in a new way in the accomplishment of a new and unitary result. As pointed out by Judge Thatcher in the District Court in *Bassick Mfg. Co. v. Adams Grease Gun Corporation* 39 F.(2d) 904, 905, in discussing the Gullborg patent, where he says: "The novelty in Gullborg's fitting was merely in the use of the same pin to furnish bearings for the slot and an abutment for the spring, and it was only this specific form of construction which was patentable. *Lyman Mfg. Co. v. Bassick Mfg. Co.* (C. C.A.) 18 F.(2d) 29. Thus it will be seen that there was no functional novelty in combining such a pin fitting with a bayonet coupler and a grease gun. The old combination of the gun, the bayonet coupler, and a pin fitting with ball and spring valve would work as well and accomplish precisely the same result. To extend the combination claims to cover the use of any old gun and any old coupler on a Gullborg fitting is clearly not permissible in view of the prior art, which limits novelty in the pin fitting to a specific form of construction and deprives the aggregation of elements of all patentable novelty as a combination. Whether its elements be old or new a combination is an invention distinct from them."

The ground for decision appearing in these opinions is not applicable to the Butler patent, claim 2. Here the question is whether Butler produced a combination which achieved a new and unitary result by the co-operation of all the elements, whether all the elements have new or modified functions as a result of changes or substitutions, or whether the old elements have only the old functions operating and co-operating in the old way to produce only an old result. We have seen that the combination consists of seven elements, all of which are old; that invention arises not from any one element, but from the

new unitary result. Defendant insists the essence of the combination is the coupler, but we have seen this is a fallacious theory, for if it were correct and available to excuse the use of the nipple to cooperate in the combination, one person might make the nipple, another the cylinder, another a group of jaws, another the sealing seat; another the piston. Each of these are old; each of them sell separately. The purchaser could quickly assemble them and then claim that each part has independent status apart from that in Butler's combination. There could then be no infringement.

The headed nipple, which co-operates with the sealing seat and jaws of the coupler and thus with the piston and cylinder is just as essential a part of the Butler invention as any of the several elements of the coupler. There is co-operation between the nipple and the jaws which produces the operation of the seal, which in turn effectuates the operation of the sealing jaws, making possible heretofore unachieved pressures. The headed nipple has new functions arising out of its co-operation with the jaws. The nipple spreads the jaws of the coupler when the latter is attached and thus prepares the coupler for operation in bringing about a mechanically strong and lubricant seal joint. In detaching the coupler the head of the nipple engages and pushes the jaws outwardly. These in turn push the piston backward, thereby effecting the release of the coupler from the nipple. The pressure and the action of the nipple are essential because the nipple alone makes it possible to build up in the cylinder of the coupler a grease pressure which will force the jaws into gripping enforcement with the nipple. The nipple is not merely a receptacle. It becomes an element which coacts to influence and make possible the desired operation of the coupler mechanism.

Butler was the first to utilize a headed nipple and a compressor as co-operating elements of a combination whereby a grease-tight and mechanically strong connection between compressor and bearing were effected automatically in and by the grease pumping operation of the compressor alone.

The high pressure delivery of grease from the compressor to the interior of the bearing, due to the strong and grease-tight attachment of the grease gun to the passageway of the bearing, was a new

15 F. Supp. 871

useful, and unitary result. It could not be accomplished with anything less than the combination of all of the elements included in Butler. Each part of the combination performed new functions and operated and co-operated in new ways in order to accomplish the single new result. The invention of Butler resides in the combination and not in one specific element. Every one of the seven old elements' functions became essential factors in the new combination. The situation is not one where the language of the Supreme Court in the *Gulborg Case* (56 S.Ct. 787, 791, 80 L.Ed. —) is applicable, for in the sense that the Supreme Court used the term pioneer, Butler is equally a pioneer. A completely new unitary result is achieved; something never accomplished before. Just as the Supreme Court said of the Berliner patent, "each element was necessary to the operation of the other."

What has been said with reference to the *Hollingshead* and *Rogers Cases* is equally applicable to the recent decision of Judge Schoonmaker in *Stewart-Warner v. Rogers*, and *Stewart-Warner v. Universal Lubricating System, Inc.*, 15 F.Supp. 410, in the District Court for the Western District of Pennsylvania.

Defendant insists that the history of the wrapper is fatal to Butler's claim in view of the fact that the third claim was canceled and that the present claim construed as contended by plaintiff is equivalent to the rejected claim. I do not believe such result follows, for the plaintiff is not asking to have claim 2 interpreted or construed in such way as to include the mechanism of canceled claim 3. There is no estoppel as contended.

Defendant argues that to decree this combination valid is to deprive prior patentees of valid old elements included in the combination of their rights and to limit them and their uses. But we believe that the complaint is not well founded. Defendant is free to make and use the old articles for use in the old manner taught by the prior art, but when these old elements are included in the new combination, achieving a new and unitary result, we may not deny validity; "then, indeed, the protection which is promised by the constitution and laws of the United States to inventors is a poor sham. Many of the most valuable patents are combinations of nonpatentable elements, and the only effective mode of preventing infringement is by suits against those who, by furnishing

the parts which distinguish the combination, make it possible for others to assemble and use the combination, and who, by advertisement of the sale of such parts and otherwise, intentionally solicit and promote such invasions of the patentee's rights." *Thomson-Houston Electric Co. v. Ohio Brass Co.*, 80 F. 712, 721 (C.C.A. 6), opinion by Judge Taft.

Defendant argues at length that the sealing mechanism of Butler is not in combination with the gripping mechanism but constitutes mere aggregation. It is to be observed, however, that the operation of the gripping mechanism is absolutely dependent upon the operation of the sealing mechanism and that the operation of the latter is dependent upon the operation of the former. Each is dependent upon the other. Functioning in co-operation and co-ordination is necessary to produce the desired result. This is not aggregation.

A great deal of attention has been given to the argument that the Butler invention must be limited to a flimsy spring finger between the piston and the jaws of the coupler. Irrespective of the decision of the Circuit Court of Appeals for the Eighth Circuit (*Stewart-Warner Corporation v. Jiffy Lubricator Co.*, 81 F.(2d) 786), the record of which is not before us, it is sufficient to say that the evidence here presented discloses clearly that the operability of the Butler invention was not dependent upon any particular degree of springiness; that the device will operate satisfactorily to accomplish all the results described by Butler, if the piston is rigid or very springy, or only slightly so. Furthermore, there is nothing in the claim of the Butler invention which does not apply to the rigid assembly of Butler's original device, in evidence, in the same manner as it applies to the flexible sample made and produced by defendant. Butler in no place makes any claim which recognizes as essential this factor. I cannot read into claim 2 any requirement of springiness or spring fingers.

Defendant cites certain prior art. Newton patent, No. 1,118,876, discloses a device for use in testing under pressures of 100 or 150 pounds per square inch the air brake hose couplings of cars in railroad trains. It includes no headed nipple, lubricant compressor, aperture for discharging grease, apertured sealing seat carried by a piston for engagement with the nipple, and nothing whereby the pres-

sure of the lubricant on the piston will move the said element to compress forcibly while the lubricant is passing through the connecting parts. It teaches nothing of what Butler achieved. The modified structure produced by the defendant I believe does not follow the teaching of Newton. It is impractical for Newton's purposes, and does not teach what Butler taught.

Defendant insists that Lincoln cannot contributorily infringe the Butler patent because plaintiff's coupler part is not constructed according to the Butler patent, and claim 2 does not properly cover plaintiff's hydraulic apparatus. I believe the premises are not well founded, but that plaintiff's construction follows the teaching of claim 2.

[5] Defendant contends that nonuse of Butler device for some time renders the patent therefor subject to a strict construction, and that it should be construed so that it will not be infringed by Kleen-seal fittings. It seems that Butler did not manufacture under his patent for two or three years, but immediately upon the purchase of the patent, plaintiff began to manufacture under the same and put its product into the widest possible commercial use, and such use has grown to the extent that the combination is used on 99 per cent. of the automobiles made and sold in America. This success had been attained a year prior to the commencement of manufacture and sale of the nipple of defendant. There is no legal reason why, when commercial success has resulted and a late infringer seeks to defend, he should be allowed to say that the patent is limited in some way because in the first two or three years of its life no manufacture took place. There is estoppel where defendant did not begin its manufacture until after commercial success had been achieved by the new owner of the patent.

Defendant contends that its nipples may be used in association with compressors and nozzles other than those of the Butler patent. To my mind this is an unimportant fact. The round-headed and straight-sided nipple which defendant first

designed could be used with all of the other compressors, but could not be used with devices built in accord with Butler. When defendant changed from a non-infringing device which it could use with other nozzles, to infringing devices which could be used and were intended to be used in combination with plaintiff's compressors, it began its infringement.

As Walker on Patents (6th Ed.) § 554, said:

"But where the machine or other property thus furnished, is useful for some other purpose than to be a part of a patented combination, or to make a patented article, or to be operated upon by a patented machine, or to be used in performing a patented process, and where he who furnishes the property, does not intend to know, when furnishing the same, that it is to be thus used, he incurs no liability in an action for infringement.

"But if he knew or intended that the property furnished by him was to be used in either of the infringing ways, he cannot defeat an action for infringement, by showing that the furnished property could have been used in some non-infringing way.

"In the absence of specific proof of knowledge or intent, the fact that the property furnished could be used with an article or machine which in itself could not be an infringement and that there are many such articles or machines in use is sufficient to absolve one who supplies the property from the charge of infringement."

[6] I conclude, therefore, that claim 1 is a valid patentable combination; that the defendant's fittings sold, with the knowledge and understanding that the same were to be used in co-operation with the Alford compressor, are a contributory infringement, and that there is nothing in defendant's contentions to avert the resulting consequences.

The findings of fact and conclusions of law incorporated herein will be included in my formal findings and conclusions adopted this date.

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IN THE
DISTRICT COURT OF THE UNITED STATES
FOR THE NORTHERN DISTRICT OF ILLINOIS,
EASTERN DIVISION.

STEWART-WARNER CORPORATION,
Plaintiff.

vs.

LEVALLY, ET AL.,
Defendants.

FINDINGS OF FACT AND CONCLUSIONS OF LAW.

I find the facts to be as follows:

(1) Plaintiff is a Virginia corporation and is the owner of the Butler patent No. 1,593,791, and of all rights thereunder.

(2) Defendant Lincoln Engineering Company of Illinois is the distributor for the Chicago territory of lubricating apparatus manufactured by the Lincoln Engineering Company of St. Louis, Missouri, a Missouri corporation.

(3) The defense of this suit is being conducted by and under the control of Lincoln Engineering Company of St. Louis, Missouri, a Missouri corporation.

(4) The Butler patent in suit No. 1,593,791 illustrates, describes, and claims lubricating apparatus in which a headed or shouldered nipple or fitting is provided for attachment to each bearing of an automobile or other machine to be supplied with lubricant from a lubricant compressor or pump by successively attaching to the nipple, a coupler with which the nipple cooperates to make a lubricant-tight connection by engagement against the end of the nipple, and which coupler has jaws engageable about the throat of the nipple automatically to grip the nipple when the compressor is operated in the customary way to deliver lubricant to a bearing. The tightness of the seal effected between the nipple and the coupler, and the tightness of the grip between the nipple and the coupler, are increased proportionately with increases in the pressure of the lubricant being supplied to the bearing.

(5) In practical operation grease pressures running up to thousands of pounds per square inch are frequently required in order to force the grease into the interstices of a bearing.

(6) When the compressor is operated to inject grease under these high pressures, the tendency is to burst the compressor, coupler and the nipple, and to break open the con-

nection between the coupler and the nipple by forcing these parts asunder.

(7) Because of the tremendous pressures which must be developed in a lubricating system, it is important in order to prevent leakage of lubricant to secure the maximum tightness of seal and the maximum mechanical grip. Both the strength of the grip and the tightness of the seal must be proportional to the pressure of the grease to be transmitted. If the seal is not sufficiently tight, the grease will escape,—and the requisite pressure cannot be developed. If the grip is not sufficiently strong, the parts will be forced asunder.

(8) In the Butler combination the automatic end seal and the automatic grip both become more effective as the lubricant pressure increases and the need for a more effective seal and grip becomes greater.

(9) In the Butler patent the end seal member is moveable and thus may adjust itself to fittings of slightly different dimensions.

605 (10) Any resiliency in part 42, referred to in the Butler patent as constituting "spring fingers," serves the purpose of compensating for any slight out-of-roundness of the fitting.

(11) Butler, applicant for the patent in suit, presented to his solicitors for the purpose of preparing the application for the patent in suit, a sample device including a coupler, the jaws of which were forced into clamping engagement with the nipple by a relatively rigid, hollow cylindrical part, corresponding exactly to the disclosure in Fig. 2 of the Butler patent here in suit. Claim 2 of the patent describes this early sample of the invention.

(12) Butler was the first to propose or to devise a lubricating system in which the sealing of the joint between the end of the nipple and the coupler, and the mechanical grip between the nipple and the coupler, were effected automatically by the pressure of the lubricant in and by the normal pumping operation of the compressor.

(13) Claim 2 of the Butler patent describes in more or less detail, a combination of seven elements which may be enumerated as nipple, compressor, cylinder, piston, aperture, jaws, and sealing seat. Each and all of these parts cooperate with one another in new ways in the accomplishment of a new and unitary result.

(14) Prior to manufacturing and selling the Alemite Hy-

draulic system of the patent in suit (exemplified in Plaintiff's Exhibits 13 to 20 and 22 to 25, inclusive) plaintiff sold lubricating apparatus (Plaintiff's Exhibits 9 and 12) of the types illustrated in Gullborg patent No. 1,307,734 and Zerk patent No. 1,475,980.

606 (15) Plaintiff commenced selling the Alemite Hydraulic lubricating equipment exemplified in Plaintiff's Exhibits 13 to 20 and 22 to 25, inclusive, in April, 1933.

(16) Plaintiff sold 281,555,000 of the Alemite Hydraulic fitting parts of the combination during the period from April, 1933, to March, 1936, and during this same period sold 6,306,000 of the Alemite Hydraulic coupler parts thereof.

(17) Of the 6,306,000 Alemite Hydraulic coupler parts sold during the period from April, 1933, to March, 1936, approximately 4,485,000 were sold with their associated compressors to automobile manufacturers, to be put in the tool kits of the cars at the factory.

(18) The Alemite Hydraulic lubricating equipment embodying the invention of the patent in suit rapidly superseded the Gullborg and the Zerk lubricating equipment because:

(a) Under this equipment, it was not necessary to manipulate any coupler mechanism in the operation of attaching and detaching the coupler to and from the fitting,—as was necessary in effecting a connection between a Gullborg coupler and fitting, and

(b) It was not necessary for the user to apply force to hold the coupler against the fitting to prevent separation of these parts,—as was required in effecting a connection between the coupling nozzle and fitting of the Zerk lubricating system.

Within eight months after its introduction on the market, the plaintiff's Alemite Hydraulic system had been adopted as the factory lubricating equipment of every automobile and truck made in the United States, with the single exception of the Duesenberg.

607 (19) The mechanism embodied in the means by which the jaws are compressed about the nipple of the Alemite Hydraulic system, is identical in its mechanical principles with that disclosed in the Butler patent. It is a simple equivalent involving a mere reversal of parts.

(20) The Alemite Hydraulic system comprises the combination of elements set forth in claim 2 of the Butler patent.

(21) The Lincoln Engineering Company of Missouri initially engaged in the business of making and selling automobile lubricating equipment in 1925, supplying its equipment exclusively to plaintiff. This relationship between the Lincoln Company and the plaintiff continued for several years thereafter, until 1933.

(22) When, shortly after January 1, 1933, Lincoln Engineering Company began selling automobile lubricating apparatus to others than Alemite, the sales of such apparatus, equipped with couplers or nozzles of its own manufacture, were made with the knowledge and expectation that the purchasers would use the apparatus in combination and conjunction with Alemite fitting.

(23) In May, 1933, Mr. A. P. Fox, the vice-president and designing engineer of Lincoln Engineering Company of Missouri, became familiar with the nipple parts of the Alemite Hydraulic system. Although he had known of the compressor and coupler parts at an earlier date, he became familiar with them at least as early as January, 1935.

(24) The Lincoln Company's Kleenseal nipples were thereafter sold with the knowledge that they could be substituted for the plaintiff's nipple part of the Alemite Hydraulic combination, and that they would be so combined in use. Claim 2 applies to the combination in the same way, regardless whether it incorporates the Lincoln Company's Kleenseal nipple part of the plaintiff's nipple part.

608 (25) The dimensions of the Lincoln Kleenseal fitting are exactly such as to make it cooperate satisfactorily with an Alemite Hydraulic coupler. If the dimensions selected had been slightly different, such cooperation would have been impossible. Similar fittings of slightly different dimensions would have had all other utilities which have been ascribed to the Lincoln Company's fittings, and would have cost no more to make.

(26) The defendants John R. LeVally and Frederick A. Faville did not, as individuals, either jointly or severally, sell any Lincoln Kleenseal fittings.

(27) Defendants sold "Lincoln Kleenseal" fittings with the knowledge that they were to be used in combination with the compressor and coupler parts of the Butler combination as sold by the plaintiff for use with plaintiff's Alemite Hydraulic coupler equipped grease guns.

(28) The Lincoln Engineering Company of Missouri ex-

pected that automobiles equipped with the Lincoln nipple part of the combination and sold in the United States; would be lubricated at garages and services stations. The plaintiff had previously sold millions of the compressors and coupler parts of the combination, and had endeavored to supply every public garage and service station in the United States.

(29) The Lincoln Engineering Company of Missouri in its Kleenseal fittings, duplicated, fitting for fitting, all of the arbitrary dimensions of the entire line of Alemite Hydraulic fittings.

(30) The Lincoln Engineering Company did not sell any of its grease guns or nozzles to automobile manufacturers for tool kit equipment of automobiles sold in the United States, even though the automobiles were equipped with Lincoln Kleenseal fittings.

609 (31) There is nothing in the Butler patent which requires the use of spring fingers which can yield a substantial amount.

(32) The Lincoln Engineering Company initially submitted to the Standards Division of General Motors Corporation a fitting like the Kleenseal fitting, but without the peripheral groove or shoulder or head. But General Motors never purchased these ungrooved fittings. Instead, it purchased the Kleenseal fittings having the groove, and cooperable with Alemite Hydraulic couplers.

(33) The Alemite Hydraulic coupler will grip and form a sealed connection with a Lincoln Kleenseal fitting as well as with an Alemite Hydraulic fitting and claim 2 of the Butler patent describes one combination as well as the other.

(34) Defendant's model of Fig. 2 of the Butler patent does not accurately or fairly represent the invention of Butler.

(35) Defendants' Exhibit A-61 does not correspond to the alleged drawing thereof, Defendants' Exhibit C-21.

(36) Defendants' expert, stated, that none of the prior art except Winkley Reissue Patent No. 14,667 accomplishes the results obtained by the Butler patent.

(37) The Winkley Reissue patent No. 14,667 does not disclose the radially movable locking elements, the piston, or the means actuated by the piston for compressively clutching the locking elements upon the nipple, as Butler's invention is defined in claim 2 of his patent. The Winkley patent discloses a coupler having a spring pressed sealing member. It is not in any way analogous to the combination of elements defined in Butler's claim 2.

610 (38) The particular shape of the oil cup shown in the Richardson patent No. 8,251 has no significance of functional utility.

(39) The patents to Paul No. 621,276, Ulleland No. 1,253,309, and Pinel French No. 327,557, each discloses a construction readily distinguishable from that claimed by Butler in that in each of these prior art patents the locking elements are not actuated by any piston not automatically by the pressure of the grease.

(40) The patent to Newton No. 1,118,876 discloses a train hose testing appliance which was never intended to be used for high pressure lubrication and could not be used for such purpose without making a great many alterations of an inventive character in its construction. It does not embody the combination of Claim 2 of the Butler patent.

(41) Defendants' representation, Exhibit A-68, differs in many material respects from the disclosure of the Newton patent No. 1,118,876, but even with all of the changes which have been incorporated in it in an endeavor to make it work, it is not a commercially feasible or practically operative device for high pressure lubrication.

My conclusions of law are as follows:

(1) This Court has jurisdiction of this suit and of all of the parties thereto.

(2) The Lincoln Engineering Company of Missouri is bound by the decree herein.

(3) Defendants John R. LeVally and Frederick A. Faville did not, as individuals, either jointly or severally, infringe claim 2 of the Butler patent, and the bill of complaint should be dismissed as to these parties.

(4) Claim 2 of the Butler patent No. 1,593,791 describes a new and useful improvement in lubricating apparatus.
611 The combinations of elements set forth in this claim are not anticipated by any combination disclosed in any patent, publication, or prior use antedating the application for the Butler patent.

(5) Butler was the first to have invented the combination set forth in claim 2 of his patent No. 1,593,791.

(6) The Butler patent contains an adequate disclosure of a novel form of lubricating apparatus which could be made and used for the intended purpose by a mechanic skilled in the art of making lubricating apparatus.

(7) All of the parts of the lubricating system invented by Butler and disclosed in his patent, cooperate in a novel man-

ner to produce a new and unitary result. Each part is dependent upon the other for the performance of its functions, and each part performs new functions because of the presence and cooperation of the other parts.

(8) Claim 2 of the Butler patent No. 1,593,791 is valid.

(9) Defendants have contributorily infringed claim 2 of the Butler patent by their sales of Kleenseal nipples or fittings exemplified in Plaintiff's Exhibits 27a and 27b.

(10) Plaintiff is entitled to a writ of permanent injunction enjoining and restraining the defendant Lincoln Engineering Company of Illinois, its officers, agents, employees, associates and confederates, from making, using, and selling lubricating apparatus, particularly fittings of the kind exemplified in Plaintiff's Exhibits 27a and 27b, or any other device or devices embodying the invention of claim 2 of Butler patent No. 1,593,791, or any of the parts thereof, or any of the coupler or fitting parts adapted and intended to be used in combinations embodying the invention of said patent, and from offering or advertising so to do, and from aiding or abetting, or in 612 any way contributing to the infringement of said patent.

(11) Plaintiff is entitled to recover from the defendants the profits which said defendants have made, and the damages which plaintiff has suffered by reason of the said defendants' infringement of the Butler patent in suit, and to recover its costs and disbursements of this proceeding, in accordance with the statutes and rules in such cases made and provided.

I adopt as a part of these findings and conclusions of law and incorporate herein as a part hereof by reference all findings and conclusions of law included in my memorandum opinion entered as of even date hereof.

Entered this _____ day of July, A. D. 1936.

Walter C. Lindley,
Judge.

Filed July 15, 1936.

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Opinion of Judge Lindley Upon Petition for Rehearing
Delivered October 5, 1936.

Stewart-Warner Corporation v. Levally et al.,
16 F. Supp. 778-783.

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**STEWART-WARNER CORPORATION
v. LEVALLY et al.**

No. 13955.

District Court, N. D. Illinois, E. D.

Oct. 5, 1936.

1. Equity ⇐392

Practice of rearguing issues previously determined in petition for rehearing is not to be encouraged.

2. Patents ⇐315

In patent infringement suit, reasonable diligence before hearing in procuring evidence offered as newly discovered, as ground for rehearing, held not shown, where such evidence consisted of statements made to Patent Office in course of solicitation of another patent which were available before trial.

3. Equity ⇐392

Trial court cannot consider evidence on rehearing which could have been discovered with reasonable diligence before trial.

4. Patents ⇐315

New evidence must be material or helpful in determining issues to constitute ground for granting rehearing in patent infringement suit.

[2, 3] Defendant alleges that, in trial, it has discovered additional evidence, consisting basically of statements made to the Patent Office in the course of the solicitation of Bystricky patent 2,016,800, issued on October 8, 1935, to plaintiff, as assignee. Aside from the question as to materiality, when the patent was issued on October 8, 1935, its contents and the file wrapper thereof became available to the public, including defendant. Any time thereafter any one could have obtained a complete transcript of the record in and about the application for allowance of the patent. Moreover, at the time of the trial herein, defendant itself had in its possession a transcript of the record of Stewart-Warner v. Rogers, 291 U. S. 304, 54 S. Ct. 638, 78 L. Ed. 1011, 29 AFTR 101, 102, 103, 104, 105, 106, 107, 108, 109, 110, 111, 112, 113, 114, 115, 116, 117, 118, 119, 120, 121, 122, 123, 124, 125, 126, 127, 128, 129, 130, 131, 132, 133, 134, 135, 136, 137, 138, 139, 140, 141, 142, 143, 144, 145, 146, 147, 148, 149, 150, 151, 152, 153, 154, 155, 156, 157, 158, 159, 160, 161, 162, 163, 164, 165, 166, 167, 168, 169, 170, 171, 172, 173, 174, 175, 176, 177, 178, 179, 180, 181, 182, 183, 184, 185, 186, 187, 188, 189, 190, 191, 192, 193, 194, 195, 196, 197, 198, 199, 200, 201, 202, 203, 204, 205, 206, 207, 208, 209, 210, 211, 212, 213, 214, 215, 216, 217, 218, 219, 220, 221, 222, 223, 224, 225, 226, 227, 228, 229, 230, 231, 232, 233, 234, 235, 236, 237, 238, 239, 240, 241, 242, 243, 244, 245, 246, 247, 248, 249, 250, 251, 252, 253, 254, 255, 256, 257, 258, 259, 260, 261, 262, 263, 264, 265, 266, 267, 268, 269, 270, 271, 272, 273, 274, 275, 276, 277, 278, 279, 280, 281, 282, 283, 284, 285, 286, 287, 288, 289, 290, 291, 292, 293, 294, 295, 296, 297, 298, 299, 300, 301, 302, 303, 304, 305, 306, 307, 308, 309, 310, 311, 312, 313, 314, 315, 316, 317, 318, 319, 320, 321, 322, 323, 324, 325, 326, 327, 328, 329, 330, 331, 332, 333, 334, 335, 336, 337, 338, 339, 340, 341, 342, 343, 344, 345, 346, 347, 348, 349, 350, 351, 352, 353, 354, 355, 356, 357, 358, 359, 360, 361, 362, 363, 364, 365, 366, 367, 368, 369, 370, 371, 372, 373, 374, 375, 376, 377, 378, 379, 380, 381, 382, 383, 384, 385, 386, 387, 388, 389, 390, 391, 392, 393, 394, 395, 396, 397, 398, 399, 400, 401, 402, 403, 404, 405, 406, 407, 408, 409, 410, 411, 412, 413, 414, 415, 416, 417, 418, 419, 420, 421, 422, 423, 424, 425, 426, 427, 428, 429, 430, 431, 432, 433, 434, 435, 436, 437, 438, 439, 440, 441, 442, 443, 444, 445, 446, 447, 448, 449, 450, 451, 452, 453, 454, 455, 456, 457, 458, 459, 460, 461, 462, 463, 464, 465, 466, 467, 468, 469, 470, 471, 472, 473, 474, 475, 476, 477, 478, 479, 480, 481, 482, 483, 484, 485, 486, 487, 488, 489, 490, 491, 492, 493, 494, 495, 496, 497, 498, 499, 500, 501, 502, 503, 504, 505, 506, 507, 508, 509, 510, 511, 512, 513, 514, 515, 516, 517, 518, 519, 520, 521, 522, 523, 524, 525, 526, 527, 528, 529, 530, 531, 532, 533, 534, 535, 536, 537, 538, 539, 540, 541, 542, 543, 544, 545, 546, 547, 548, 549, 550, 551, 552, 553, 554, 555, 556, 557, 558, 559, 560, 561, 562, 563, 564, 565, 566, 567, 568, 569, 570, 571, 572, 573, 574, 575, 576, 577, 578, 579, 580, 581, 582, 583, 584, 585, 586, 587, 588, 589, 590, 591, 592, 593, 594, 595, 596, 597, 598, 599, 600, 601, 602, 603, 604, 605, 606, 607, 608, 609, 610, 611, 612, 613, 614, 615, 616, 617, 618, 619, 620, 621, 622, 623, 624, 625, 626, 627, 628, 629, 630, 631, 632, 633, 634, 635, 636, 637, 638, 639, 640, 641, 642, 643, 644, 645, 646, 647, 648, 649, 650, 651, 652, 653, 654, 655, 656, 657, 658, 659, 660, 661, 662, 663, 664, 665, 666, 667, 668, 669, 670, 671, 672, 673, 674, 675, 676, 677, 678, 679, 680, 681, 682, 683, 684, 685, 686, 687, 688, 689, 690, 691, 692, 693, 694, 695, 696, 697, 698, 699, 700, 701, 702, 703, 704, 705, 706, 707, 708, 709, 710, 711, 712, 713, 714, 715, 716, 717, 718, 719, 720, 721, 722, 723, 724, 725, 726, 727, 728, 729, 730, 731, 732, 733, 734, 735, 736, 737, 738, 739, 740, 741, 742, 743, 744, 745, 746, 747, 748, 749, 750, 751, 752, 753, 754, 755, 756, 757, 758, 759, 760, 761, 762, 763, 764, 765, 766, 767, 768, 769, 770, 771, 772, 773, 774, 775, 776, 777, 778, 779, 780, 781, 782, 783, 784, 785, 786, 787, 788, 789, 790, 791, 792, 793, 794, 795, 796, 797, 798, 799, 800, 801, 802, 803, 804, 805, 806, 807, 808, 809, 810, 811, 812, 813, 814, 815, 816, 817, 818, 819, 820, 821, 822, 823, 824, 825, 826, 827, 828, 829, 830, 831, 832, 833, 834, 835, 836, 837, 838, 839, 840, 841, 842, 843, 844, 845, 846, 847, 848, 849, 850, 851, 852, 853, 854, 855, 856, 857, 858, 859, 860, 861, 862, 863, 864, 865, 866, 867, 868, 869, 870, 871, 872, 873, 874, 875, 876, 877,

125; *McLeod v. New Albany (C.C.A.)* F. 878; *Allis v. Stowell (C.C.)* 85 F. Moneyweight Scale Co. v. Toledo Computing Scale Co., 199 F. 905, 118 C.C. 285; *Australian Knitting Co. v. Wright's Health Underwear Co.*, 121 F. 221, 56 C.C.A. 678.

Thus in *Combustion Utilities Corporation v. Worcester Gaslight Co. (C.C.)* 190 F. 185, a rehearing was denied where the defendant claimed to have discovered that another patent anticipated the one in suit, when such patent was referred to in the defendant's brief and record upon the original hearing. Similarly, because of the discovery of a mortgage on the patent, which was shown by the file wrapper then put in evidence. *Money-Weight Scale Co. v. Toledo Computing Scale Co. (C.C.A.)* 199 F. 905.

(4) However, despite the insufficient showing in this respect, the court, at a sacrifice of no inconsiderable time and labor, has examined the offered evidence and the other suggestions of counsel with a view to determining whether, had the plaintiff exercised diligence, there is anything in the newly offered evidence which would have changed the result or which bore materially upon the issues adjudicated. Obviously, the first question to be determined, is whether the new evidence sought to be introduced would have been material & helpful in determining the issues. If not, its proffer is wholly futile. Section 67, Walker on Patents; *Munson v. New York (C.C.)* 11 F. 72; *New York Grape Sugar Co. v. American Grape Sugar Co. (C.C.)* 85 F. 212; *Bates on Fed. Procedure*, vol. 2, § 683; *Foster's Fed. Practice* (2d Ed.) 352.

(5) The statement in the file wrapper, to which the defendant directs the attention of the court, was made by counsel for plaintiff herein as solicitors for the Bystricky patent, in the course of argument as to patentability of certain claims previously rejected, to the effect that the combination there submitted, had, in the short time it had been on the market, been universally accepted by manufacturers, and become standard equipment upon automobiles made in the United States. It was urged by the solicitor, therefore, that any doubts as to patentability should be resolved in favor of the applicant. In itself, of course, the statement is wholly valueless in the record, but it is urged by defendant that, followed to its logical conclusion, it

means that the Alemite Hydraulic System considered by the court in the present case was thereby admitted to be exclusively the invention of Bystricky.

Upon examination of the Bystricky patent and a re-examination of the record herein, although the validity of the patent is not before me, it seems obvious to me that Butler was a pioneer in the field of lubricant pressure in the sense that that term was used by the Supreme Court in the *Leeds & Catlin Case (Leeds & Catlin Co. v. Victor Talking Machine Co.)*, 213 U.S. 301, 29 S.Ct. 495, 53 L.Ed. 905, and that Bystricky invented an improvement upon the Butler construction. The findings of fact and conclusions of law heretofore entered, which I see no occasion to modify, pointed out Butler's invention and found that the Alemite System embraced the Butler invention. Nothing now urged moves me in the slightest degree to conclude otherwise.

Another statement of the solicitors in the file wrapper is that the Bystricky coupler was not "practically operative except in combination with a compressor of a certain definite type, in which means are provided to relieve or partially relieve pressure in the discharge conduit so as to facilitate disconnection of the coupler from the fitting." It is contended that this argument clearly indicated that the Alemite System does not embody the Butler invention, but rather that of Bystricky. Such statement is in nowise inconsistent with the record herein, for, as we have seen, Bystricky is merely an improvement upon Butler and used the same means for release of pressure. I conclude, therefore, that the proffered evidence, if received, would be immaterial, but if material, would not have affected the result.

The contention that the court has misconstrued the decision of the Supreme Court in *Bassick Mfg. Co. v. R. M. Hollingshead Co. (Rogers v. Alemite)*, 298 U.S. 415, 56 S.Ct. 787, 80 L.Ed. 1251, is clearly reargument of something fully presented at the original hearing. But I have again examined the opinions of the Supreme Court and have had submitted to me a transcript of the record of the *Hollingshead Case* in that court, as an exhibit in answer to the petition for rehearing. I adhere to what I have said in my opinion, findings, and conclusions in that respect.

In my memorandum, I made a statement to the effect that the record in the

Hollingshead Case was rather short. Counsel for defendant disagree. The word is one of comparative connotation. The transcript shows 181 pages of testimony, which is a short record as compared with the present one. But whether the record was short or long, is, after all, wholly immaterial. The important thing was the limited character of the issue presented to the court.

Due to some mental aberration, in the original opinion, I made the statement that the Court of Appeals for the Sixth Circuit "affirmed" the holding of the lower court. Obviously the court did not affirm the decision of the district court, but did agree with its conclusions in the respects under consideration when I used the expression.

The word "affirmed" should have been "agreed." If we attribute to the word "affirm" its strict legal significance, the error, in the words of counsel for plaintiff, was merely lapsus linguae.

We may well again refer to the character of the Butler patent. I have pointed out in my findings of fact and conclusions of law heretofore entered that Butler was the first to propose or devise a lubricating system in which the sealing of a joint between the end of the nipple and coupler and the mechanical grip between the nipple and coupler were achieved automatically by the pressure of the lubricant in and by the normal pumping operation of the compressor, and that the advantage of this combination arises from the fact that in the greasing of automobiles, in forcing grease into the bearing through the narrow opening of the fitting, thousands of pounds of pressure are sometimes utilized in order to remove and force out foreign bodies in the grease duct or channel. Former devices provided a seal by a screw connection between the coupler and the fitting, by a bayonet connection or by mere manual physical pressure. In all of these, some leakage occurred, and physical manipulation entailing some labor was necessary. In none of them could the pressure be exerted and the grease delivered perfectly without leakage, under desirable pressure, and with the saving of labor resulting from Butler's teaching. I previously pointed out, due to the peculiar shape of this nipple, its head and shoulders couple with the gripping jaws of the coupler in such a way that, when pressure is exerted and the grease passes from the coupler in-

to the fitting, the coupler grabs hold of the projecting shoulder of the nipple with its jaws and automatically, as the pressure the grease increases, simultaneously, the power, force, and closure of the connection increases, so that it is impossible for grease to escape and any desired pressure of grease may be transmitted without breakage of parts or leakage of material. All this was accomplished without further manipulation other than the easy, almost automatic, attachment of the coupler to the nipple and the application of the pressure. This, I have said, was a step forward in the greasing of automobiles. No one had ever taken it, though the art is full of grease guns and nipples. It remained for Butler to devise an easy operable combination in which the nipple and the coupler automatically co-operate, each contributing its part to the one result of high-pressure grease delivery through a sealed connection, effected automatically and increasing in efficiency with the increase of the pressure. This, I said, was invention and the combination, I held, became, therefore, a pioneer invention in the sense that the Supreme Court used that word in the *Leeds & Catlin Case*.

[6, 7] Obviously, most modern inventions are of combinations. Changes in the art are effected either by the addition of new elements, the withdrawal of existing elements, alteration in their qualities or arrangement or substitution of a new element for one previously employed. Each of these changes may effect a mere change of form, or an improvement of an old invention, or a new invention. If the new combination involves only a variation in the method of reducing the original idea to practice or if, while varying the idea of means, it neither changes its essential character nor gives substantial increase to its practical efficiency, it is a mere change of form, involving no invention. *"If the change indicates the introduction into the idea of means of a different force, a different object, or a different mode of application, it is more than a change of form, more even than an improvement; it is a separate invention. If it preserves the essential characteristics of the original invention, applying the same force to the same object by the same method, but accomplishing results with higher excellence or with greater economy of time or power, and is not the product of mechanical skill alone, it is an improvement."* Robinson on

nts, vol. 1, ch. 11, § 215, p. 299. (Ital-
mine.)

Where the apparent variation in the
invention produces no change in
effects or in the economy of time or
power, if the factors and the mode of oper-
ation of the original and improved inven-
tions are the same, the variation must be
embodiment alone; if different, the in-
ventions are entirely independent of each
other. Where the effects produced by the
invention in its changed condition differ in
degree from those accomplished by it in the
past, the change has passed beyond the lim-
its of a mere improvement and has resulted
in a new invention. If the effects, although
the same in nature, are so enhanced in ex-
tension that the original idea of means, in
the form of embodiment, could have pro-
duced them, the change is more than for-
mal, but may be either an improvement or
a new original invention. In this case, as
that wherein no change occurs in the ef-
fects, the original and improved inventions
must be compared as operative means and
examined in their mode of action as well as
in the subordinate idea of which each is
composed. If this examination discloses a
substantial difference, either in the nature
of the operation or the means, the two in-
ventions are distinct; otherwise the latter
is a mere improvement on the earlier." *Robinson on Patents*, vol. 1, ch. 11, § 216.
(Italics mine.)

So, here, Butler introduced into the art
the idea of an automatic sealing connec-
tion achieved by the size and character of
the elements, which, in themselves, were old.
But he employed a different mode of opera-
tion. He achieved his object by means of
a different force and according to a differ-
ent and new conception. His invention
then was not an improvement but a new
and separate invention, and, within the
reasoning of the Supreme Court in the
Leeds & Catlin and the *Hollingshead* and
Rogers Cases, a pioneer. In the latter two
cases the court was not dealing with a
combination patent wherein, by the use of
a nipple of a certain particular form and
shape and dimensions co-operating with
the gripping jaws of a coupler of special
form and shape, an automatic unbreakable
connection was achieved, making possible
that highly desirable thing in automobile
braking, unlimited pressure. Butler did
not combine a certain coupler with any
nipple. He did not combine a certain nip-
ple with any coupler. He was not, as the

Supreme Court believed Gullborg had
done, trying to extend his patent to a com-
bination of a certain nipple with any kind
of grease gun. Quite to the contrary, he
demonstrated conception of a new creative
thought, the achievement of a new valid
combination in which not only the coupler
was essential, but in which also the nipple
of peculiar shape and dimension was es-
sential. He produced a new combination,
a new arrangement of known elements, by
virtue of which he produced an entirely
new and beneficial result. He developed
new functions and new properties and
achieved novelty, resulting in great com-
mercial success.

In this situation, defendant entered the
field and developed its nipple of equivalent
form, shape, and dimensions, which it sold,
obviously, for use with Alemite guns, sup-
planting in the combination of Butler the
nipple essential to his success. It is a
striking fact that a nipple of this shape and
dimension was not necessary to the opera-
tion of defendant's grease gun or of any
guns other than those of plaintiff or of in-
fringers or licensees of plaintiff—a fact of
tremendous significance in determining the
purposes and intent of defendant. It sold
grease guns which operated with straight-
headed nipples as well as with nipples
with head and shoulders. It first made
straight-headed nipples and exhibited them
to General Motors Corporation, but it sold
to that company only nipples of infringing
character, a character not essential to any
combination other than plaintiff's.

Despite the fact that the court would
have been justified in denying the petition
for rehearing because nothing therein con-
stituted newly discovered evidence and be-
cause the record shows that the defendant
failed to exercise reasonable diligence to
discover the evidence claimed to be newly
discovered and despite the inclusion in cer-
tain affidavits of improper, well-nigh scan-
dalous, irrelevant averments, I have ex-
amined everything submitted, re-examined
the authorities, and again endeavored to
make myself clear. Clearly, no new mate-
rial evidence has been suggested. The at-
tempt to reargue the merits of the case,
though not exactly praiseworthy upon the
part of counsel, has been met by a re-
examination of the record and of my find-
ings and conclusions. The petition for
hearing is denied.

[8] It appears that the decree was too
broad in enjoining the manufacture and

STEWART-WARNER CORPORATION v. LEVALLY

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sale of the nipple contributorily infringing, beyond the limits of the United States. Accordingly, the original decree is vacated, and a decree properly enjoining defendants only within the United States and in conformity with my findings of fact and conclusions of law and this memorandum will be entered.

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District Court, N. D. Illinois
STEWART-WARNER CORPORATION

v.

JOHN R. LE VALLY and FREDERICK A. FAVILLE, doing business as LINCOLN ENGINEERING COMPANY OF ILLINOIS, and LINCOLN ENGINEERING CO. OF ILLINOIS

Equity No. 13955

Decided Oct. 26, 1936

Patents—Injunction—In general—

Whether court shall grant supersedeas lies within its discretions and that discretion should not be abused; supersedeas is denied where infringement is clear and can be avoided readily by slight change which defendant is already prepared to make.

Patents—Appeals to Circuit Court of Appeals—In general—

District Court approves bond on appeal, enters order and citation, but does not approve assignment of errors which put into its words something expressly disclaimed in its memoranda; court does not tell clerk what shall be incorporated in record or go in praecipe.

On defendant's petition for supersedeas and stay of injunction.

(See also 30 USPQ 343 and 31 USPQ 171.)

LYNN A. WILLIAMS for plaintiff; DELOS G. HAYNES for defendants.

LINDLEY, District Judge.—It is obvious, of course, that whether the Court shall grant a supersedeas, lies within its discretion, and that discretion should not be abused.

This case has been before the Court for some time and a rather extensive record was made up on the trial of the case. The Court expended a great deal of time, care and study in the preparation of its memoranda, its findings of fact and conclusions of law, and a decree was entered [30 USPQ 343]. A petition for rehearing was filed and an assignment of errors upon the part of the Court, and on September 12th, a rather extensive hearing was heard upon that, and again, the Court made a scrutiny of the record and again gave its best efforts to the examination of the record and the decisions which it was contended he had a complete misapprehension of, and again a memorandum was prepared and submitted to Counsel, and again a decree entered, modifying in one particular a provision of the decree which was obviously too wide [31 USPQ 171].

Now, it is desirable that litigation be ended; it is desirable that there be some diligence toward the prosecution of an appeal and the early disposition of it. I have the conviction that this patent is valid. I have the conviction that it is being infringed and an infringement of a patent is a tort. There is a continuing tort being committed by the defendants, a tort which a Court of Equity has seen fit to enjoin and a tort which the Court believes unjustified; a tort which the Court believes, by a mere minor modification in the manufacture of one small article, could be wholly avoided, and the strange commentary—the strange fact which stares us in the face, is that the particular form of manufacture, the particular shape of this small fitting, is, in no way, a vital idea to the defendant in cooperation with its other articles of manufacture, and this peculiarly shaped fitting is the one which is adapted to plaintiff's combination. Having found that this fitting was made for the express purpose of being sold to be used with and as a part of the infringed plaintiff's combination, and having found there was no excuse for the perpetuation of that

tort in the protection of the defendant's interests, I am not disposed at this time, in view of the time that has elapsed since the hearing, to grant a supersedeas. I make this statement so that it may be presented to the Court of Appeals. That Court may grant a supersedeas. I want this case heard on appeal and heard soon, and I think if I deny supersedeas, I can speed matters up so that it can be heard at the January session. I can't see that this defendant can be injured in any way. Of course, it is a selling agency, but its selling agency is allied with the manufacturer and the manufacturer defended the case. They can make their nipples, as they proposed, with a straight side; they can eliminate the head and shoulder; they can do that overnight. They have their drawings all made—they have had them for several years. They started out with the straight side nipple but the Oldsmobile people wouldn't take them.

The prayer for supersedeas will be denied, bond for the appeal to be fixed at Three Hundred (\$300.00) Dollars, and the form of the order will be the form submitted by Mr. Williams.

I don't approve of the assignment of errors, for they put into my words something which I expressly disclaimed in my memoranda, and I don't want the Court of Appeals to be misled as to what I did hold. I have tried to make it clear in the two memoranda which I prepared in this case, and I shall not be misquoted without an expression of my disapproval of the form of the assignment of errors, and I shall not tell the clerk at this time what shall be incorporated in the record and what shall go into the praecipe, because that is pre-judgment. The rule is that that should be made up when the praecipe is filed.

The bond for the appeal in this case shall be fixed at Three Hundred Dollars (\$300.00) and the citation be issued as of this date, and I suppose you can get service upon Mr. Williams at this time, since he is present.

Mr. Williams: I accept service right now.

The Court: You have your bond, Mr. Haynes?

Mr. Haynes: It will be less effort to file a bond for One Thousand Dollars than Three Hundred Dollars, as I have a bond for that amount.

The Court: Very well, I will make it One Thousand (\$1,000.00) Dollars, so that you will have it. The Massachusetts Bonding and Insurance Company is a recognized bonding company?

Mr. Haynes: It has been signed by
an attorney-in-fact who tells me his name
is registered in the Court in Chicago.

The Court: I approve the bond. Let
the record show the bond approved, or-
der entered and citation issued.

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Opinion of United States Circuit Court of Appeals for
the Seventh Circuit Delivered on June 29, 1937 (R.
823-544).

Lincoln Engineering Co. of Illinois v. Stewart-
Warner Corporation, 91 F. (2d) 767-768.

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LINCOLN ENGINEERING CO. OF ILLINOIS v. STEWART-WARNER CORPORATION
No. 6103.

Circuit Court of Appeals, Seventh Circuit.
June 29, 1937.

Rehearing Denied Sept. 15, 1937.

Patents § 26(1)

A "combination" contemplates a plurality of units, but patentable invention can only reside in a "combination" when it is considered as a unit.

[Ed. Note.—For other definitions of "Combination" (In Patent Law), see Words & Phrases.]

Patents § 41

If all elements of unit are old but have never appeared together in combination, and they coact so as to avoid charge of aggregation, the combination is not lacking in novelty so as to bar patentability.

Patents § 42

Where combination consists of five elements and inventor uses four elements in same way and for same purpose as in previous combination, but substitutes new element for remaining element of old combination and obtains desirable results, new combination is not lacking in novelty so as to bar patentability.

Patents § 41

Where combination consists of five elements and inventor uses four old elements in same way and for same purpose as in previous combination but substitutes for remaining element old and well-known element which has never been used in combination with such other four elements, new combination may be patentable.

Patents § 26(14)

An old combination may not be repeated.

Patents § 328

Patent No. 1,593,791, claim 2, dealing with a lubricating apparatus, is not invalid for anticipation by prior art.

Patents § 42

If a new product is found to be patently novel; it is immaterial whether patentable novelty is of pioneer type or mere improvement type of invention.

Patents § 328

Patent No. 1,593,791, claim 2, dealing with a lubricating apparatus, is valid, as de-

scribing a "combination," and not an "aggregation."

[Ed. Note.—For other definitions of "Aggregation," see Words & Phrases.]

9. Patents § 26(14)

The names of various parts embodied in patent did not determine whether unit was "combination" or "aggregation," and if there was coaction of elements so as to make single unitary structure, there was a patentable "combination."

10. Patents § 259(2)

The supplier of an element in a valid combination embodied in a patent might be guilty of infringement, though element was not patentable, and was old.

11. Patents § 255

If element of patented combination in very nature of its use wears out, new element may be furnished without producer's infringing.

12. Patents § 226, 259(1)

An infringer and a contributory infringer are tort-feasors.

13. Patents § 259(1)

The maker, buyer, or seller of non-patented article is guilty of "contributory infringement" only when it knows that non-patented element is to be used in connection with other elements in valid combination covered by valid patent.

[Ed. Note.—For other definitions of "Contributory Infringement," see Words & Phrases.]

14. Patents § 259(1)

There can be no "contributory infringement" unless elements in question comprise a "combination," and not merely an "aggregation," since no valid patent can cover an "aggregation."

15. Patents § 25

As respects patents, the term "aggregation" defines a phase of general term "non-invention," and when claims compose plurality of elements and their individual or collective selection falls to evidence exercise of inventive faculty, it is not a patentable discovery, regardless of whether coaction of elements is present, but inventive concept may reside in selection of part or parts of numerous old elements, if selection is unusual and hitherto pressing unsolved problem is thereby overcome.

16. Patents \Leftarrow 25, 26(1)

Invention may be evidenced by modifying coaction of elements, but there may be invention without coaction.

17. Patents \Leftarrow 25, 26(1)

As respects distinction between "combination," which is patentable, and "aggregation," which is not, a "combination" is present if there be correlation or co-ordination of elements which mutually contributes to accomplishment of some result, and there need be no interdependency in sense of one element being dependent on the others for functioning.

18. Patents \Leftarrow 45

As respects patentable novelty, evidence of wide and popular acceptance of patented apparatus is controlling in doubtful cases.

19. Patents \Leftarrow 328

Patent No. 1,593,791, claim 2, dealing with a lubricating apparatus, is not invalid for lack of patentable novelty.

20. Patents \Leftarrow 328

Patent No. 1,593,791, claim 2, dealing with a lubricating apparatus, was infringed.

Appeal from the District Court of the United States for the Northern District of Illinois, Eastern Division.

Patent infringement suit by the Stewart-Warner Corporation against the Lincoln Engineering Company of Illinois. From an adverse decree, defendant appeals.

Affirmed.

Leonard L. Kallah, of Philadelphia, Pa., Delos G. Haynes and Lloyd R. Koenig, both of St. Louis, Mo., and Milton T. Miller, of Chicago, Ill., for appellant.

Lynn A. Williams, of Chicago, Ill., for appellee.

Before EVANS, SPARKS, and MAJOR, Circuit Judges.

EVANS, Circuit Judge.

Appellee is the owner of the Butler Patent, No. 1,593,791. Appellant is the distributor of the Lincoln Engineering Company of St. Louis, Missouri, which is conducting and controlling the defense to this litigation. It is charged with infringing the Butler Patent. The trial was a long one, and the District Court prepared his own findings and conclusions which fully covered the nature of the invention, the claims, the

status, the state of the art, as well as other material issues. These findings favor the appellee.

Accompanying the findings was an opinion which set forth the reasons for the conclusions which the court reached. About three months later, upon a petition for a hearing filed by appellant, the court filed a second opinion, which may be found in *Stewart-Warner Co. v. Levally* (D.C.) 1 F.Supp. 778. Three weeks later the court filed a third opinion which dealt with questions raised by appellant. The third opinion appears in 31 U.S.P.Q. 195. Reference is made to the places where these opinions appear because it will, we think, justify a more abbreviated statement of the facts. Different conclusions respecting the same claim (No. 2) of this patent, so appellant claims were reached by other Federal courts. *Stewart-Warner Corporation v. Jiffy Lubricator Co. (C.C.A.)* 81 F. (2d) 786; *Stewart-Warner Corporation v. Rogers* (D.C.) 1 F.Supp. 410.

The decree subsequently entered granted an injunction that restrained future infringements of the patent and directed an accounting of profits and damages occasioned by past infringements.

The application for the Butler patent was filed February, 1923, and the patent issued July 27, 1926. It related to Lubricating Apparatus.

Claim No. 2, the one in issue, reads as follows:

"2. The combination with a headed nipple for receiving lubricant, of a lubricating compressor having a coupling member connecting said compressor and nipple comprising a cylinder, a piston movable within the cylinder and having an aperture for the discharge of lubricant thereof, an aperture sealing seat carried by said piston for engagement with the end of the nipple, connecting the piston aperture with a passage through the nipple, radially movable locking elements carried by the cylinder cooperating with the nipple and actuated by said piston for compressively clutching the elements upon the nipple whereby the pressure of the lubricant on said piston will move the piston to forcibly compress said elements while the lubricant is passing through said connecting parts."

The patent deals with a lubricating apparatus. Butler's object, as stated by him, was "to provide a means of forcing under high pressure fluid and semi-fluid lubricants

compounds into bearings, * * * in that foreign material and used lubricant may be forced out of the bearing.

* * * His specifications describe a "co-operating bearing and self lubricating valve, * * * having reservoir for lubricant and means automatically 'feeding' the lubricant from to the bearing, * * * and automatic and semi-automatic means of action between the bearing valve and lubricating pressure means * * * described.

George Lindley, describing the patent,

* * * Butler was the first to propose to devise a lubricating system in the sealing of the joint between the end of the nipple and the coupler and the mechanical grip between the nipple and the coupler were achieved automatically by the pressure of the lubricant in and by the normal pumping operation of the compressor, * * * the advantage of this combination is from the fact that in the greasing of machines, in forcing grease into the bearing through the narrow opening of the fitting, thousands of pounds of pressure are sometimes utilized * * * due to the peculiar shape of this nipple, its head and its jaws couple with the gripping jaws of the coupler in such a way that, when pressure is exerted and the grease passes from the coupler into the fitting, the coupler grabs the projecting shoulder of the nipple with its jaws and automatically, as the pressure of the grease increases, simultaneously, by power, force, and closure of the connection increases, so that it is impossible for the grease to escape and any desired pressure of grease may be transmitted without leakage of parts or leakage of material. This was accomplished without further manipulation other than the easy, almost automatic, attachment of the coupler to the nipple and the application of the pressure."

In short, the asserted superiority and value of the Butler lubricating apparatus is twofold: (a) The apparatus permits of application of thousands of pounds of pressure with no loss of grease, and (b) an operable device wherein the coupler's grip increases with the pressure of the

substance of the more important findings of the trial court is:

In practical operations, grease pressure running up to thousands of pounds per

square inch are frequently required in order to force the grease into the interstices of a bearing.

2. When the compressor is operated under these high pressures, the tendency is to burst the compressor, coupler, and the nipple, and to break open the connection between the coupler and the nipple by forcing these parts asunder. To avoid this break or separation of coupler and nipple, the maximum tightness of seal and the maximum mechanical grip must be obtained and must be proportional to the pressure of the grease to be transmitted.

3. In the Butler apparatus, the automatic end seal and the automatic grip both become more effective as the lubricant pressure increases and the need for a more effective seal and grip becomes greater. Butler's seal member is movable and thus may adjust itself to fittings of slightly different dimensions.

4. In the Butler combination the end seal and automatic grip both become more effective as the lubricant pressure increases. The end seal member is movable and thus may adjust itself to fittings of slightly different dimensions. Any resiliency referred to in the patent as constituting spring fingers serves the purpose of compensating for any slight out of roundness of the fitting.

5. Butler presented to his solicitor a sample device including a coupler, the jaws of which were forced into clamping engagement with the nipple by a relatively rigid, hollow, cylindrical part corresponding exactly to the disclosure of Figure 2 in the Butler patent.

6. Butler was the first to devise a lubricating system in which the sealing of the joint between the end of the nipple and coupler and the mechanical grip were effected automatically by the pressure of the lubricant, which pressure was produced by the normal pumping operation of the compressor.

7. Claim 2 is the only one in issue and describes a combination of seven elements: (a) nipple, (b) a compressor, (c) cylinder, (d) piston, (e) aperture, (f) jaws, (g) sealing seat. "Each and all of these parts cooperate with one another in new ways in the accomplishment of a new and unitary result."

8. Appellee began selling Butler lubricating equipment in April, 1933, and prior thereto sold apparatus covered by the Gullborg and Zerk patents. From April, 1933,

to March, 1936, it sold 281,555,000 fitting parts of the Butler combination, and 6,806,000 coupler parts. Over half of the latter were sold with the associate compressors to automobile manufacturers, to be put in the tool kits at the factory. Within eight months after its introduction, the Butler system had been adopted as the factory lubricating equipment of every automobile and truck made in the United States with one exception.

9. "The mechanism embodied in the means by which the jaws are compressed about the nipple of * * * (appellee's) system is identical in its mechanical principles with that disclosed in the Butler patent. It is a simple equivalent involving a mere reversal of parts."

10. Appellee's system comprises a combination of elements, as set forth in claim 2 of the Butler patent.

11. Prior to 1933, appellant was engaged in the business of making and selling automobile lubricating equipment to appellee. In 1933, it began selling lubricating apparatus to others. It made and sold couplers and nozzles with the expectation that they would be used with appellee's apparatus. Its nipples were sold with the knowledge that they could, and would, be used as part of appellee's combination. The dimensions of appellant's fittings are exactly such as to fit appellee's coupler. If they did not select exact dimensions such cooperation would have been impossible. Appellant's "Lincoln Kleenseal Fittings" were sold to be used in combination with the compressor and coupler parts of the Butler combination as made and sold by appellee. Appellee sold its compressor and coupler parts of the combination to public garages and service stations in the United States, and appellant offered its fitting parts to be used by the said garages in connection with the Butler combination. Appellant duplicated fitting for fitting all of the arbitrary dimensions of the entire line of appellee's fittings.

12. The Butler patent does not require the use of spring fingers which can yield a substantial amount.

13. Appellant's model of Figure 2 of the Butler patent does not accurately or fairly represent the invention of Butler.

14. Claim 2 of the Butler patent describes both a "Lincoln Kleenseal" fitting, appellant's product, and "Alemite Hydraulic" fitting, appellee's product.

As conclusions, the court found:

That claim 2 of the patent is valid, and defendant contributorily infringed it by sale of "Kleenseal" nipples or fittings, as amplified in plaintiff's Exhibits 27a and 27b, and that appellee is entitled to an injunction and to an accounting.

Appellant challenges the decree on these separate, distinct grounds, stating each with commendable frankness, brevity, and clarity:

(1) Butler's hose coupler can not be validly claimed in combination with a patented lubricant receiving nipple or an air compressor, particularly where his commercial purpose is not merely to monopolize the hose coupler, but to include in the monopoly the admittedly old device which is used with it. To support this position appellant relies upon *Bassick Manufacturing Co. v. R. I. Hollingshead Co.* (Rogers v. Alemite Corp.), 298 U.S. 415, 56 S.Ct. 787, 791, 1 L.Ed. 1251.

(2) The coupler of the Butler patent shown in Figure 2 is not the so-called "Alemite Hydraulic" coupler. Supporting this position, appellant relies upon the facts brought out by the evidence and the holdings in *Stewart-Warner v. Jiffy Lubricator Co.* (C.C.A.) 81 F. (2d) 786.

(3) The Butler multi-jaw chuck type hose coupler is not a patentable improvement over the multi-type hose coupler of the prior art. As bearing upon this issue, appellant contends that the evidence does not support the findings of validity because the Butler hose coupler as described by Butler both in Figure 2 and in his claim never went into commercial use. It likewise argues that its extensive use where the trade was so dominated by Stewart-Warner is not persuasive of validity.

The importance of the suit and the effect of the Bassick opinion upon the whole body of patent law make it impossible for us to dispose of the case in an opinion of desirable length and satisfactory brevity.

While going no further than is necessary to defeat the patent in the present case, the conclusion from appellant's brief is unavoidable, that *Bassick Mfg. Co. v. R. I. Hollingshead*, supra, revolutionized the law of patents and repudiated the position of courts, including many decisions in this circuit, long accepted as the law in such cases. This revolutionary concept was accepted and applied by the District Court

Pennsylvania) in *Stewart-Warner v. Universal Co.*, 15 F.Supp. 410.

The Bassick opinion, while dealing with another patent, is more persuasive in this case, because the patent in issue here deals with some of the same old elements of a combination as were described in the Gullborg patent, the validity and infringement of which were the subject matter of the *Bassick Mfg. Co. v. R. M. Hollingshead* opinion.

The Gullborg patent had been the subject of much litigation, as pointed out in the opinion, and it dealt, as here with (1) a type of pin fitting, (2) a grease gun, (3) a connecting hose, and (4) a type of coupler.

While it is, of course, conceded that every opinion must be read in the light of the facts to which it applies, yet there are cases where the differences in the facts are so inconsequential, so immaterial, that the opinion must be accepted as authoritative and controlling.

The uppermost question in this case is the controlling effect of the *Bassick Mfg. Co. v. R. M. Hollingshead* opinion, *supra*. We are not disposed to limit it in order to bring about an avoidance of any new principle it may announce. Nor are we inclined to give it an effect which was not intended, if it does not follow from a fair construction of its language.

The novel proposition which appellant seeks to apply to the present case is to be found in the language on pages 424, 425, of 298 U.S., 56 S.Ct. 787, 791, 80 L.Ed. 1251. There it was said:

"It is plain that Gullborg invented improvements of two of the mechanical elements of an old combination consisting of grease pump, hose, hose-coupler, and a grease cup or pin fitting. First, he contrived an improved pin fitting. This he patented as such. No. 1,307,733. Secondly, he invented an improved form of coupler to be attached to the end of the hose leading from the pump to the fitting. Instead of patenting this, as he did the pin fitting, he claimed a combination of pump, hose-coupler, and pin fitting, and embodied in the combination his improved form of coupler. No. 1,307,734, the patent in suit; claims 1-6, 8, and 10. He further claimed the combination between his patented pin fitting and any form of grease gun whether that claimed in his patent or unpatented and old in the art. Claims 14 and 15. The question then is whether, by this

method, the patentee, by improving one element of an old combination whose construction and operation is otherwise unchanged, may, in effect, repatent the old combination by reclaiming it with the improved element substituted for the old element. That this cannot be done is shown by numerous cases in this and other federal courts."

The paragraph of the opinion which follows the quotation serves as a modifier of the strict letter of the rule thus announced. There, the court says:

"*Leeds & Catlin Co. v. Victor Talking Machine Co.*, 213 U.S. 301, 325, 29 S.Ct. 495, 53 L.Ed. 805, on which the respondent relies, is not in point. There the patent was a pioneer patent and the combination was of elements which were novel and neither of which possessed utility without the other. Each element was necessary to the operation of the other. The invention did not, as here, consist of the mere improvement of one element of an old combination."

If the court announced a rule in the *Bassick* Case as contended by appellant's counsel, or if all of its implications (the substitution of a new element for an old element does not afford the basis of a valid patent) be accepted as the present law respecting the validity of patents then *Leeds & Catlin Co. v. Victor Talking Machine Co.*, 213 U.S. 301, 29 S.Ct. 495, 53 L.Ed. 805, is overruled. However, instead of stating that the *Leeds & Catlin* opinion is overruled, the court distinguished it and thereby impliedly recognized the soundness of the rule there announced.

Until and unless there is an express repudiation of the *Leeds & Catlin Co. v. Victor Talking Machine Co.* Case, we can not accept the *Bassick Mfg. Co. v. R. M. Hollingshead* opinion as being inconsistent with the views stated in the former opinion. In other words, we must apply to the instant case the rules of law which govern and apply the tests which have long been applied to determine whether the *Butler* combination is a patentable invention.

[1] In dealing with product patents and their validity it might be observed that the word "combination" is somewhat unfortunate. A combination contemplates a plurality of units, yet patentable invention can only reside in a combination when it (the combination) is considered as a unit. For convenience's sake, courts speak of elements in a combination as units in and of them-

selves. It is only for the sake of convenience that reference is made to such elements as 1, 2, 3, 4, and 5. Each and every valid claim of a patent covers a unit, although in a combination claim the unit may have five parts or elements. When we consider a claim it is clear that one unit must differ from another unit if one element, say element three in one combination is different from element three in another combination. To illustrate: If one mixes five different colored paints in stated proportions, he would have a product which might be denominated X. X must be viewed as a unit. If the same individual mixed in the same proportions five different colored paints, four of which were similar to the ones in the first combination but one was different, the final product would not be the same. In testing the validity of any machine or product patent, then, whether it be what is commonly called a combination, or a single, a noncomposite substance, the following propositions may be accepted as sound:

[2] 1. All the elements may be old but if they have never appeared together in combination and they co-act so as to avoid the charge of aggregation, the unit *may* constitute a valid claim of a patent.

[3] 2. Where a combination consists of five elements—1, 2, 3, 4, and 5—and the inventor uses four old elements—1, 2, 3, and 5,—in the same way and for same purpose as in the previous combination, but substitutes a new element 4 for old element 4 of the old combination and obtains desirable results, the new combination may be the subject of a valid claim. It is not anticipated by the previous combination.

[4] 3. Likewise, one may substitute for element 4 an old and well-known element but which has never been used in combination with elements 1, 2, 3, and 5, and these elements being presented in the new combination for the first time may be the subject of a valid patent.

In stating these propositions, we have used the word "*may*" for there are other factors to be considered in determining patentability. For instance, the novelty may not be patentable. The advance may represent the skill of the artisan or the mechanic, not the genius of the inventor. Perhaps it would be better to say that the objection that the combination is lacking in novelty is not sound under the conditions enumerated.

[5] Equally clear is the law which denies to anyone the right to repatent an old combination.

[6] Accepting the foregoing principles as sound and applying them to the instant case, we have no difficulty in distinguishing any of the prior art. Nor are we troubled by the decision in the Bassick Case. The Butler coupling member and his nipple head are novel. Their structures are clearly distinguishable from the prior art. Whether the other mentioned elements are old is immaterial.

[7] The only validity questions left relate to combination as distinguished from aggregation and the character of the discovery—whether it marks patentable novelty or mechanical skill. In passing, it might be observed that if a new product is found to be patentably novel, it is immaterial whether said patentable novelty is of the pioneer type or "the mere improvement type" of invention.

Appellant also relies upon the Bassick Case as authority for its contention that contributory infringement is not disclosed upon a showing that it furnished nipples and grease guns, even though made in such a way as to be used as an element in the Butler combination.

The last paragraph of the Bassick opinion is cited in support of appellant's position. It reads as follows:

"We are of the opinion that the owner of the patents cannot extend the monopoly of its patent for a pin fitting to preclude the use therewith of any grease gun not embodying the improvement in the coupling device evidenced by the patent in suit; and cannot extend the monopoly of the combination patent in suit to prevent the use of a pin fitting which does not infringe the fitting patent, 1,307,733, with a gun having a coupler such as that claimed in the patent in suit."

We accept, of course, without question this opinion as applied to the facts in the case that was before the Supreme Court.

In the instant case, Butler does not seek to extend the monopoly of a patent for a pin fitting or to preclude the use of a grease gun in any apparatus not embodying the improvement described in the patent.

Two questions are determinative: First, did Butler set forth a valid patentable combination when he wrote his claim No. 2? Second, did the sale of a headed nipple or a

abscant compressor made for the sole purpose of being used in connection with the apparatus made according to the Butler patent constitute infringement?

8, 9) *Combination or Aggregation.* As we view claim 2 of the Butler patent, it calls combination, not aggregation. It is not the names of the various parts that determine this question. If there be coaction of elements so as to make a single unitary structure, we have a combination. The nipple head may be a non-composite apparatus. It may be the subject of a valid patent claim. Likewise, it may be part of a combination. 10) In the instant case, it is conceded that the headed nipple was not patented. More, it is not patentable. It will be assumed that it was old. Nevertheless, if it is an element in an otherwise valid combination (due to the novel coupling method), it is a unit of said combination and a third party supplying it, if other necessary facts are shown, may thereby infringe.

Whether the supplier of headed nipples or other elements of the combination set forth in claim 2 is a contributory infringer depends first on whether the element supplied is a part of a valid combination (as distinguished from an aggregation), and second, on whether the producer so constructs it that it can be said that it was knowingly made with the intention that it would be used in connection with the patented combination.

11) There is an exception to this statement—If an element of a patented combination in the very nature of its use wears out and a new one is supplied, it may be furnished without the producer's infringing. *Heyer v. Duplicator Mfg. Co.*, 263 U.S. 100, 44 S.Ct. 31, 68 L.Ed. 189; *Leeds & Catlin Co. v. Victor Talking Machine Co.*, 213 U.S. 325, 29 S.Ct. 503, 53 L.Ed. 816. But, where the intent is present, as here, to supply separate units of a patented combination and not as a renewal of a worn out part, contributory infringement is disclosed.

The findings of the District Court on this question respecting the dimensions of appellant's headed nipple clearly show an intention to make parts which could only be used in connection with the patented combination. If, then, the Butler claim No. 2 disclosed a valid combination, infringement is shown.

12) In dealing with this subject of contributory infringement, it might be observed that we are dealing with a phase of the gen-

eral subject of torts. An infringer is a tortfeasor. A contributory infringer is one whose action contributes to the infringement.

13) Because of the statute, the owner of a patent is entitled to exclude others from making, selling, or using the patented product. Violation of any of these rights makes the violator a tortfeasor, an infringer. Making, buying or selling a non-patented article is not of itself infringement. It only becomes so when said maker, seller or user does so knowing that the non-patented element is to be used in connection with other elements in a valid combination covered by a valid patent. This is the doctrine of contributory infringement.

In the instant case, the court has made findings, and the facts leave no doubt as to the soundness of such findings, to the effect that the non-patented parts made by appellant were not only intended for use in connection with Butler's patented combination but they could hardly be used otherwise. The size and dimensions of the fittings most conclusively demonstrate this fact.

It might be asserted that appellant did not infringe when it manufactured one element of the product for it could have been sold to one who would use it other than in the Butler patent combination. However, when it appears that such products were made by the appellant and sold to garages and it further appears that the fittings were of such measurement as to preclude their use except on appellee's patented apparatus, contributory infringement both in selling and in using is established.

To establish contributory infringement the following facts must appear: (1) a valid patent; (2) ordinarily in the case of a product patent covering a combination; (3) the alleged infringer must make or supply one or more of the elements of the combination with the knowledge and intention that the same is to be used in the patented combination.

Contributory infringement is the outgrowth or result of the application of the following legal propositions:

(1) A patentable combination is a unit in the contemplation of the law.

(2) Some elements of the combination may be old and others new, or all old, or all new.

(3) One who makes, sells or uses the combination without permission of the patentee is an infringer.

(4) One may be a contributory infringer although he makes, sells or uses an element that is old and not covered or coverable by a patent.

(5) When the manufacturer makes, uses or sells an unpatented (an old) element, he becomes a contributory infringer only when the element is knowingly made, sold or to be used as a part of a patentable combination without patentee's express or implied consent.

(6) Implied consent exists when in the ordinary use of the patentable combination one element constantly and frequently wears out and must be replaced. *Heyer v. Dupli-cator Mfg. Co.*, *supra*. Whether there is a consent is often a fact issue, but not involved in the instant suit.

[14] In the last analysis this question of contributory infringement in the instant suit must be determined by the existence or absence of a valid combination wherein one of the essential elements was a product made by appellant. If the elements do not spell a combination, but are merely an aggregation, there is of course no contributory infringement.

For obviously, infringement can exist only when there is a valid patent. No valid patent can cover a group of elements which are correctly termed an aggregation and which do not conform to the correct legal definition of a combination. There is a valid combination only when the element-headed nipple-co-acts with the lubricant compressor and the coupling member. If two of these elements do not co-act and the third element does not likewise co-act with one of the other two members, we do not have a case of valid combination.

Doubt over this issue can only arise when one of the elements may in itself serve a multiple of purposes. It may be used outside the combination of the patent. If so, its use is valid and legitimate. The determining fact issue is the intent and the purpose it serves, and was intended to serve when made or sold. If made, sold or used as an intended element in the combination which is the basis of the patent claim, it is a case of contributory infringement, otherwise not.

In disposing of the defense of aggregation, we have accepted the rather common meaning of that word and, for the purpose of the argument *only*, assumed it to be a valid defense in patent cases when established. We have adopted this meaning for

the purpose of the argument only, for wise we would hesitate before accept-

In our opinion the defense of aggregation is considerably overworked. The "aggregation" is usually preceded by the word "mere" and describes a group of elements which fall far short of invention in the user's opinion. It is a generic term used quite loosely to define various features which fail to embody patentable coveries.

To illustrate, it is used when a mechanism with a series of independent units perform their functions separately and are influenced by the action of any other unit being considered. In other cases, it may be adopted when a mechanism is composed of numerous units, but their selection does not call for the exercise of the inventive faculty. In such a case, the discovery may appear to be new but does not attain the high status of invention.

[15] We believe the better view is to accept the term "aggregation," if used as defining a phase of the general concept of "non-invention." When claims are composed of a plurality of elements and their individual or collective selection falls to evidence the exercise of the inventive faculty, it is of course not a patentable discovery regardless of whether combination of elements is present or absent. On the other hand, an inventive concept may result in the selection of a part or parts of numerous old elements. If the selection is unique and a hitherto pressing unsolved problem thereby overcome, it answers the test of the statute.

[16] Invention may be evidenced by the modifying coaction of the elements. If there is, the coaction may furnish the satisfactory evidence of the patentability of the discovery. It is hardly logical, however, to require without it (coaction) there can be no invention.

It is one who "has invented or discovered any new and useful art, machine, manufacture, or composition of matter, or any new or useful improvements thereof, etc.," who is, under the statute, entitled to the right of an inventor, and under prescribed circumstances is entitled to a patent which will protect his invention. The term "aggregation" is not used. It has been adopted by the legal profession as descriptive of a machine or composition of matter, etc., that falls short of invention usually because the elements of the composition do not o-

parts, too, have recognized it as applicable to the machine or composition of matter in short of invention, because it manifests the skill of the mechanic rather than the skill of the inventor. This has led to emphasis on the term "coaction" of elements when applied to said composition or machine.

When among the group of elements there is correlation or co-ordination of elements which mutually contribute to the same result, there may be invention, notwithstanding there are many decisions which have arbitrarily announced that patentable discoveries are not present unless there is coaction of elements which results in a new or better product.

We are convinced that where there is correlation, cooperation, or co-ordination resulting in mutuality of achievement of a common purpose and contributing to accomplish a desired result, a patentable combination may well be present. Nor is it proper to say that the correlation or cooperation depends on each element's affecting each of the other elements.

[11] In short, in attempting to restrict aggregation to its proper field, it might be said that a combination is present if there be correlation or co-ordination of elements which mutually contributes to the accomplishment of some result and there need be no interdependency in the sense of one element being dependent on the others for functioning.

We are inclined to go still further and question the wisdom of necessitating the presence of a coaction of parts to constitute a valid combination. True, absence or presence of coaction may bear upon the character of the skill required to solve the problem. It is entirely possible to conceive of a case where the selection of the elements which are to act together to produce a desirable or advantageous result, would invoke the exercise of the inventive faculty. While this view may not harmonize with many of the decisions, and it is not applied in the instant case, it seems to us the more logical one. For when we attempt to distinguish between inventive faculty and the skill of the mechanic, we must admit that the former often finds expression in the selection of the particular element and it is the selection of elements that solved the problem, improved the product, or brought about the desired economies in production costs. Its cooperation with the other elements may be very limited, in fact, limited to mutuality of effect or functioning to a common purpose.

Patentable Novelty of the Butler Apparatus. Appellant argues as one of its three major grounds for reversal of the decree that the advance or improvement which Butler made over the prior art did not constitute invention, but merely evidenced the skill of a mechanic confronted by an ordinary mechanical problem.

Upon this issue the District Court found squarely against the appellant and in its opinion pointed to the differences between the prior art structures and the Butler apparatus.

We are not convinced that the discovery belongs to the pioneer class. It was an improvement, but not an outstanding advance. Whether that improvement was such as to justify the issuance of a patent may well be and is seriously debated.

[18] We are not impressed by the evidence of wide and popular acceptance of the patented apparatus which is so controlling in doubtful cases. *Wahl Clipper Corp. v. Andis Clipper Co.* (C.C.A.) 66 F.(2d) 162.

Appellee occupies such a position in this lubricating field that any lubricating system it might offer to the garages and automobile manufacturers would result in enormous sales of parts. There is no doubt but that the figures appearing in the court's findings, standing alone, are impressive. A sale of 280,000,000 fitting parts in three years, by any company at any time, is quite startling. They would be more impressive if we knew how many parts were sold under the Zerk patent or under the Gullborg patent, both owned by appellee. The number of automobiles in the United States and the number of parts necessary to supply all of them are both enormous. A company, like the appellee, is apparently able to have its product made part of the standard equipment of most automobile companies, and therefore would naturally sell millions of parts of a lubricating system throughout the entire United States. It is for this reason that we have not allowed the sale figures to influence our judgment on this issue of validity of the patent.

It is only after observation of the various lubricating systems that we have come to the same conclusion as was reached by the District Court. If the advance which Butler made was merely the solution of a mechanical problem, we are at a loss to understand why that solution was so long delayed. Holding one part of the lubricating system against another while pressure was applied and grease squirted in all directions, or mak-

ing the connection by the pin and slot or bayonet type while crawling under cars and reaching between spokes of a wheel, was so unsatisfactory as compared to the Butler method that the delay in producing this new method of connection is explainable only upon the theory that the problem was beyond the solution of the mechanic skilled in the art.

What was the problem which confronted the maker of lubricating systems? First and foremost was the need of high pressure apparatus. The pressure had increased in the passing years. First 500 to 750 pounds was considered high, then 1500 to 2000 pounds. The Butler system permits of pressure up to 7500 pounds. It is apparent that high pressure was extremely desirable. The difficulty to be overcome in the making of a high pressure system was in the connection between the coupler and the pin head. Butler's solution was most satisfactory because the higher the pressure, the tighter the connection—the better the fitting.

Another problem which confronted the manufacturer was easy connection. Crawling under the car or reaching points rather inaccessible was unsatisfactory.

[19] The trial judge found, and there is testimony to support this position, that in the lubricating field the method adopted had never been used before. It was novel in the lubricating field. It may not have been wholly new in the entire field of mechanics, but it was novel in this particular field. Its conception or its selection, under all the circumstances, we conclude was invention and entitled to the protection of a patent.

Appellant argues, as an additional ground for reversal, that claim 2 of the Butler patent and Fig. 2 of the drawings accompanying the same do not cover its accused nipple. It likewise argues that appellee's "Alemite Hydraulic" coupler is not the coupler of the Butler patent.

The District Court found squarely against appellant on this issue.

The question has been elaborately argued both on the oral argument and in the brief. To reproduce the drawings and set forth the positions of the two sides would almost double the length of this opinion, and we fear we would not add much to the statement of our conclusions respecting these conflicting positions.

The question is not whether Fig. 2 of drawings fully represents the concept of inventor. Figures which accompany patents are often presented merely to elucidate the thought expressed in the specifications. Their study is decidedly helpful in most cases, but it can hardly be expected that all of the possible variations in structures will be set forth in specifications and drawings. Frequently the improved type is described in detail. True, there are instances where specificity is necessary in order to distinguish the invention from prior art. More frequently however, it is the principle of operation which is best illustrated rather than an effort to conform the invention to the exact figures shown in drawings.

This seems to have been the thought of Judge Lindley when he said:

"The Alemite Hydraulic System (appellee's) comprises the combination of elements set forth in claim 2 of the Butler patent. * * * There is nothing in the Butler patent which requires the use of spigot fingers which can yield a substantial amount of pressure. * * * The Alemite Hydraulic coupler will grip and form a sealed combination with a Lincoln Kleenseal fitting as well as with an Alemite Hydraulic fitting and claim 2 of the Butler patent described one combination as well as the other."

He further stated:

"The mechanism embodied in the mechanism by which the jaws are compressed about the nipple of the Alemite Hydraulic system, identical in its mechanical principles with that disclosed in the Butler patent. It is a simple equivalent involving a mere reversal of parts. The Alemite Hydraulic system comprises the combination of elements set forth in claim 2 of the Butler patent."

[20] Our conclusion is that such departures from the Butler patent as were made in the commercial structures were nevertheless the equivalent of the Butler claim and they embodied the mechanical principles which were described in the Butler patent. In other words, we agree with the District Court that appellee's Alemite Hydraulic system was an embodiment of claim 2 of the Butler patent.

The decree is

Affirmed.

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CHARLES ELMORE CROPLEY
CLERK

IN THE
Supreme Court of the United States

OCTOBER TERM, A. D. 1937.

No. 608

LINCOLN ENGINEERING CO. OF ILLINOIS,
Defendant-Petitioner,
vs.

STEWART-WARNER CORPORATION,
Plaintiff-Respondent.

RESPONDENT'S BRIEF.

LYNN A. WILLIAMS,
Counsel for Respondent.

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**THE FINDINGS OF FACT IN THE DISTRICT COURT
AS ADOPTED AND APPROVED BY THE SEVENTH
CIRCUIT COURT OF APPEALS ARE AS FOLLOWS:**

In the right-hand margin opposite each of these findings, we have indicated the page of our brief at which the particular finding is discussed. In our brief we have in each instance referred to the evidence upon which the particular finding was based.

Discussed
at
Brief
Page

The Courts' First Finding of Fact Was That:

"Plaintiff is a Virginia corporation and is the owner of the Butler patent No. 1,593,791, and of all rights thereunder" 16

The Courts' Second Finding of Fact Was That:

"Defendant Lincoln Engineering Company of Illinois is the distributor for the Chicago territory of lubricating apparatus manufactured by the Lincoln Engineering Company of St. Louis, Missouri, a Missouri corporation" 16

The Courts' Third Finding of Fact Was That:

"The defense of this suit is being conducted by and under the control of Lincoln Engineering Company of St. Louis, Missouri, a Missouri corporation" 16

The Courts' Fourteenth Finding of Fact Was That:

"Prior to manufacturing and selling the Ale-mite Hydraulic system of the patent in suit (exemplified in Plaintiff's Exhibits 13 to 20 and 22 to 25, inclusive) plaintiff sold lubricating apparatus (Plaintiff's Exhibits 9 and 12) of the types illustrated in Gullborg patent No. 1,307,734 and Zerk patent No. 1,475,980" 16